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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057877
Party	Plaintiff G6 Hospitality IP LLC
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PUBLIC VERSION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

G6 HOSPITALITY IP LLC,

Petitioner,

v.

MOTEL ONE GMBH,

Registrant.

Cancellation No. 92057877

Trademark Registration No. 3,505,545

Mark: MOTEL ONE (& Design)

Date Registered: September 23, 2008

**PETITIONER’S MOTION FOR LEAVE TO AMEND
AND FOR SUMMARY JUDGMENT,
AND MEMORANDUM IN SUPPORT THEREOF**

Petitioner, G6 Hospitality IP LLC (“G6”), by and through its undersigned counsel,
hereby moves as follows:

- 1) Pursuant to Fed. R. Civ. P. 15(a), 37 C.F.R. § 2.115 and Trademark Board Manual of Procedure (“TBMP”) § 507.02, that the Trademark Trial and Appeal Board (“Board”) grant Petitioner leave to amend its Petition to Cancel in the above-captioned cancellation proceeding as shown in the proposed Amended Petition to Cancel (Exs. A-1, A-2)¹, as a result of actions taken by Registrant, Motel One GmbH (“Motel One”), since the institution of the proceeding (including amending the subject

¹ Exhibit A-1 is a signed, clean copy of the proposed Amended Petition, and Exhibit A-2 is a red-lined copy, as provided by TBMP § 507.01.

registration (the “Amended Registration”)), and based on the evidence produced in discovery in this case; and

2) Pursuant to Fed. R. Civ. P. 56 and TBMP § 528, that the Board enter summary judgment in Petitioner’s favor on Counts I and/or II of the amended Petition by cancelling the Amended Registration on the grounds that:

- a. the Amended Registration is void as asserted in Amended Count I because the only remaining service claimed in the Amended Registration, “making reservations of temporary lodging for others,” (the “Reservation Services”) does not constitute a separately registrable service as applied to a party’s own lodging services; and/or
- b. that the Reservation Services in the Amended Registration are not in fact provided “for others” but are for the benefit of Registrant itself, such that the mark has not been used by Registrant but has been abandoned, as asserted in Amended Count II.

Pursuant to 37 C.F.R. § 1127(d) and TBMP § 528.03, this proceeding will be suspended pending disposition of Petitioner’s motion. “When any party files a motion . . . for summary judgment . . . the case will be suspended by the . . . Board with respect to all matters not germane to the motion.” The basis for this motion is set forth in the Memorandum below, which is incorporated by reference herein.

MEMORANDUM IN SUPPORT

I. INTRODUCTION

This cancellation proceeding concerns a registration that is now a shell of its former self at the time the proceeding was instituted. When Registrant, an operator of European hotels, obtained a registration for the mark MOTEL ONE under 15 U.S.C. § 1126(e) in 2008, that registration listed a host of services all pertaining to the hospitality industry, including, primarily, temporary accommodation services. However, after this proceeding was instituted, Registrant was forced by the approaching deadline for its Section 71 Declaration in September 2014 to abandon any pretense that it was using the MOTEL ONE mark in the United States for anything other than the Reservation Services, which it claimed it was using through its website accessible from the United States – and so it deleted from the subject registration every service other than the Reservation Services and instead filed a separate ITU application, now suspended, to cover the other services.

By doing so, Registrant severed the Reservation Services from its lodging services, resulting in a registration that improperly seeks to cover an ancillary service that is not separately registrable from lodging services. Meanwhile, in discovery, Registrant has produced information confirming that all of its lodging facilities are in Europe, and showing that all of these facilities are owned, directly or indirectly, by Registrant. Thus, Registrant is not providing the Reservation Service “for others” as claimed in the Amended Registration, but is providing those services *for the benefit of itself*.

As a result of the actions taken by Registrant after institution of the cancellation, and the information Registrant has provided during discovery, Petitioner now has two additional bases to support its effort to cancel the Amended Registration: first, that the Reservation Services are not

separately registrable as applied to Registrant's own lodging services, such that the Amended Registration should be found void; and second, that the mark has been abandoned due to non-use, arising from Registrant's failure to provide the Registration Services "for others." Petitioner therefore moves that it be granted leave to amend its petition as shown in the attached Exhibit A, and moves for summary judgment on Counts I and II of the Amended Petition.²

II. PROCEDURAL AND FACTUAL BACKGROUND

This proceeding was instituted upon Petitioner's filing a petition to cancel against Motel One's original registration for the mark MOTEL ONE (& Design) on September 16, 2013. The original registration, which Motel One obtained under the auspices of Section 44(e) of the Lanham Act, 15 U.S.C. § 1126(e), was for the following services:

professional business consulting services for catering and accommodation enterprises, including technical assistance in the establishment and operation of catering and accommodation businesses; consulting services for business management, planning and supervision of catering and accommodation enterprises; franchising of catering enterprises, namely, offering business know-how concerning the establishment and/or operation of catering and accommodation enterprises" in international class 35; and "providing temporary accommodation; catering services; making reservations of temporary lodging for others; technical consulting, namely, computer consultation in connection with catering and temporary accommodation enterprises" in international class 42.

Thus, the original Registration included "providing temporary accommodation" (the "Lodging Services") as well as the Reservation Services, in Class 42, as well as catering services (the "Catering Services") and several other services in Classes 35 and 42 (collectively, the "Other Services"). Because the original U.S. application was filed under Section 44(e), Registrant did not have to show use of the mark in connection with any of these services in order

² Simultaneous motions to amend and for summary judgment are expressly contemplated by the Board. See TBMP § 528.07 and cases cited therein.

to obtain the original Registration. Petitioner claimed in its original Petition, inter alia, that the MOTEL ONE registration should be canceled because it had been abandoned due to non-use by Registrant, and because the MOTEL ONE mark caused a likelihood of confusion with Petitioner's several incontestable registrations for MOTEL 6.

Nearly a year later, on July 25, 2014, as the six-year anniversary of the original Registration approached, and plainly because it had not yet offered the Lodging Services, the Catering Services, or the Other Services in the United States, Registrant mooted much of the original Petition to Cancel by filing a Declaration of Continued Use under Section 71 that deleted the Lodging Services, the Catering Services, and all of the Other Services, and left in place only the Reservation Services. (Ex. B.) Shortly thereafter, on August 18, 2014, Registrant filed a separate application for MOTEL ONE under Section 1(b), Serial No. 86/368,963, for the Lodging Services and the Catering Services, which had been deleted from the original registration (the "ITU Application"). (Ex. C.) Then, on December 11, 2014, the Examining Attorney in the ITU Application issued an Office Action, refusing to register the MOTEL ONE mark under Section 1(d) as against the registration for "ONE" for "hotel services for preferred customers" owned by SH Group Global IP Holdings, L.L.C. ("SH"), and noting the presence of additional senior applications for variations of the mark "1 HOTEL" owned by SH. (Ex. D.)³

Meanwhile, discovery had commenced in the instant proceeding. During discovery, in response to interrogatories and document requests from Petitioner, Registrant provided information confirming that it had not provided the Lodging Services in the United States. Specifically, the discovery confirmed that none of the properties through which Registrant offers the Lodging Services are located in the United States. Registrant's Responses and Objections to

³ Exhibit D comprises the Office Action and the relevant marks cited by the Examiner, but for convenience omits other marks referenced by the Examiner for other purposes.

Petitioner's First Set of Interrogatories (Ex. E) at 11. In fact, in the very introduction to Registrant's Answer, Registrant stated that it "runs a chain of hotels in Europe." Answer at 1. Moreover, the discovery revealed that [REDACTED] [REDACTED] As for the Reservation Services, these are offered through Registrant's website, accessible in the United States, showing the availability of Registrant's properties only in Europe. (Ex. G.)

Recently, on June 10, 2015, Registrant filed a response to the Office Action in the ITU Application. (Ex. H.) That response comprised, in its entirety, a consent agreement between Registrant and SH regarding the parties' use and registration of their respective marks. The agreement was remarkably terse and silent on such issues as the respective segments of the lodging market that each party was targeting through the use of its respective marks. The very next day, June 11, 2015, the Examining Attorney issued a decision rejecting the consent agreement as an unsatisfactory "naked consent," maintaining the refusal and suspending the ITU application in view of the additional senior SH applications. (Ex. I.)⁴

III. ARGUMENT

A. Petitioner Should Be Given Leave To Amend Its Petition Based On Registrant's Amendment to the Registration And Information Produced During Discovery

Rule 15(a)(2) of the Federal Rules of Civil Procedure provides that a party may amend its pleading with the court's leave and that the court should "freely give leave when justice so requires." Fed. R. Civ. P. 15(a)(2); 37 C.F.R. § 2.115. The Board liberally grants motions for leave to amend the pleadings when information is learned during discovery and the amendment

⁴ Based on these actions taken by Registrant, and in particular the status of the ITU Application, Petitioner notes that were it not moving for summary judgment herein, it would move under TBMP § 510 for a suspension of this proceeding pending resolution of the ITU Application, as it is in connection with the ITU Application, which now includes the actual Lodging Services, that the likelihood of confusion issue would be most meaningfully contested.

will not prejudice the non-moving party. *See, e.g., American Optical Corporation v. American Olean Tile Company, Inc.*, 168 USPQ 471 (TTAB 1971) (“It has been generally held that amendments to pleadings should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties”); *Karsten Mfg. Corp. v. Editoy AG*, 79 USPQ2d 1783, 1786 (TTAB 2006) (motion for leave to amend pleading granted because grounds for new claim was learned during discovery).

In this case, Registrant’s amendment to the Registration following institution of the proceeding, and the information Registrant has produced during discovery, are the events that give rise to Petitioner’s Motion to Amend. At the time that Petitioner filed its Petition to Cancel, it was challenging Registrant’s original Registration, which included both the Lodging Services and the Reservation Services, both on the basis of abandonment for non-use and likelihood of confusion. However, during the pendency of the proceeding, as the deadline was approaching for Registrant to show its use of the mark, Registrant filed a Section 71 Declaration of Continued Use that amended the Registration by deleting the Lodging Services, among others, but retaining the Reservation Services. (Ex. B.) Registrant retained the Reservation Services evidently on the theory that its website, accessible from the United States, allows U.S. residents to make reservations at Registrant’s hotels in Europe.

However, by severing the Reservation Services from the Lodging Services and disclaiming current usage of the Lodging Services in the United States, Registrant is attempting to claim use of a clearly ancillary service, when in fact Registrant is not providing the main lodging service to which the Reservation Services are ancillary. As discussed *infra* in Section B.2 *infra*, such a service is not separately registrable, and Petitioner should be granted summary

judgment on this basis. At the very least, however, Petitioner should be granted leave to amend its Petition to Cancel to assert the revised Count I set forth therein, based on this development.

Meanwhile, as discussed above, during discovery Registrant has produced information clearly showing that every facility at which Registrant offers its Lodging Services in Europe is operated by Registrant itself or a subsidiary. As discussed *infra* at Section B.3, in such a situation, the Reservation Services in the amended Registration are not offered for the benefit of others, such as third-party licensees or franchisees, but rather for Registrant itself. Thus, Registrant has not used the Reservation Services as set forth in the amended Registration, and summary judgment should be granted on the basis of abandonment. At the very least, however, as with the ancillary services issue discussed above, Petitioner should be granted leave to amend its Petition to Cancel to assert the revised Count II set forth therein, based on these facts learned post-filing.

Granting this Motion for Leave to Amend the Petition to Cancel will not prejudice Registrant because the Motion is being filed when the proceeding is still in the pre-trial phase. *See United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993) (applicant not prejudiced because proceeding still in pre-trial phase). Denying the Motion, however, would be likely to prejudice Petitioner, as Petitioner would be barred from presenting arguments to the Board on claims that the evidence obtained after the Petition to Cancel was filed clearly supports.

Accordingly, for the foregoing reasons, Petitioner asks that the Board grant its Motion for Leave to Amend its Petition to Cancel as shown in Exhibits A-1 and A-2.

B. Summary Judgment Should Be Granted To Petitioner On Counts I And II Of The Amended Petition To Cancel

To constitute a registrable service pursuant to Section 45 of the Trademark Act the claimed service must:

- (1) be a real activity;
- (2) be qualitatively different from anything necessarily done in connection with the performance of another service; and
- (3) be performed to the order of, or for the benefit of, someone other than the applicant.

15 U.S.C.S. § 1127; TMEP § 1301.01(a). *In re Canadian Pacific Ltd.*, 224 USPQ 971 (Fed. Cir. 1985); *In re Betz Paperchem, Inc.*, 222 USPQ 89 (TTAB 1984); *In re Integrated Resources, Inc.*, 218 USPQ 829 (TTAB 1983); *In re Landmark Communications, Inc.*, 204 USPQ 692 (TTAB 1979).

In this case, summary judgment should be granted to Petitioner on Counts I and II of the Amended Petition on the following grounds: First, as to Count I, Registrant's claimed Reservation Services are not qualitatively different from activities necessary to render the Lodging Services; and second, as to Count II, the Reservation Services are not rendered for the benefit of others but only for Registrant itself. Accordingly, the Registration does not claim use of the Mark in connection with a registrable service, and summary judgment should be granted to Petitioner on the ground that the Registration is void; and/or the Reservation Services “for others” have not in fact been provided by Registrant, and Petitioner should be granted Summary Judgment on the ground of abandonment.

1. Summary Judgment Standards

Summary judgment should be granted “if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter

of law.” Fed. R. Civ. P. 56(c). The initial burden of showing the lack of a genuine issue of fact rests with the moving party. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). Once the moving party has shown prima facie that no issue of fact exists, however, the burden shifts to the non-moving party to demonstrate that specific facts exist that would justify denial of the motion. *Id.* at 324.

In a cancellation proceeding, the registrant is entitled to presumption that its mark is valid. However, the presumption is rebuttable, and if the petitioner can demonstrate through law and undisputed fact that the mark is invalid, then the registrant cannot survive summary judgment. “Mere registration does not enable a trademark holder to survive summary judgment.” *Talking Rain Beverage Co. v. South Beach Beverage Co.*, 349 F.3d 601, 603, 68 USPQ2d 1764, 1765 (9th Cir. 2003.) A petitioner need only show that a mark is invalid by a preponderance of evidence in order to rebut the presumption of validity. *West Florida Seafood Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 1125, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994).

2. Allowing Hotel Guests to Make Reservations at a Hotel Is an Ancillary Activity That Is Normal and Expected When Rendering Hotel Services

Registrant’s Reservation Services here do not qualify as a separate registrable service, because those services are necessary for, and ancillary to, Registrant’s principal service of rendering hotel services at its own facilities, and thus the Registration should be found void. It is a well-settled principle that the rendering of an activity which is “expected or routine” in connection with the provision of one’s own services is not a registrable service. *See, e.g., In re Dr. Pepper Co.*, 5 USPQ2d 1207 (TTAB 1987); *Cottonwood Financial Ltd. v. The Cash Store Financial Services, Inc.*, 778 F. Supp. 2d 726 (N.D. Tex. 2011). In other words, activities that are inherent to the provision of a primary service are not registrable. The TMEP provides the example of a grocery store that bags groceries for customers. TMEP § 1301.01(a)(iii). Bagging

groceries is a normal and expected activity rendered by grocery stores during the rendering of their primary services (i.e., selling groceries) and is thus not separately registrable. *In re Dr. Pepper Company* provides additional examples of a nonregistrability activity with a service business, such as an asserted service of offering "free" glassware to customers who have made a certain level of purchases at a gasoline station, or a lottery contest by a new shopping mall. 5 USPQ2d 1207 (Fed. Cir. 1987).

Another example of a non-registrable activity is “guaranteeing” one's own merchandise or service. Because such a guarantee is an inducement in the sale of the primary good or service and is normally expected by customers, a guarantee is not a separate registrable service. *See In re Orion Research, Inc.*, 187 USPQ 485, 486 (CCPA 1975). The “guarantee” in *Orion Research* was also said to be non-registrable because it was not offered apart from the sale of the primary business function and was not promoted separately. *Cf., e.g., In re Hennessy*, 226 USPQ 274 (TTAB 1985) (stating that “recommendation and endorsement of wines” by a wine store may be a registrable service only “if the service is marketed as a separate service and identified by the mark”).

Much like the guarantee on one's own service found not to be registrable in *Orion Research*, a reservation in advance for a room at a hotel is nothing more than a guarantee that the customer will be able to use the hotel services upon arrival at the designated date and time. Providing the ability to reserve a hotel room in advance of a stay is a customary and routine practice in the hospitality industry that every major hotel or motel chain offers to induce the sale of its hotel services. Correspondingly, hotels do not and cannot offer reservation services for use of their lodging facilities apart from the primary service of actually offering such temporary accommodations at their facilities. Allowing customers to reserve a hotel room at a hotel is an

“integral part of providing hotel services” that is not separately registrable. *Penta Hotels Limited v. Penta Tours*, 9 USPQ2d 1081 (TTAB 1988).

In this case, Registrant operates a chain of hotels in Europe using the trademark MOTEL ONE. (Answer at 1.) According to Registrant, it offers premium lodging, advertises its hotel services and has engaged in efforts to open a hotel in the United States. (*Id.* at 1-2.) Registrant does not tout that it offers reservation services, but rather that it offers lodging services. Registrant’s principal service is operating a chain of hotels, which provide temporary accommodations. In the process of rendering its hotel services, Registrant, as is customary in the hotel industry, regularly allows customers to reserve a room at its hotel in advance. By allowing customers to reserve a room at its hotels, Registrant is not offering a separate service, but rather is engaging in an expected, routine aspect of operating its own hotels.

There is no factual dispute in the record regarding this aspect of Registrant’s services. Accordingly, the Board can and should grant summary judgment to Petitioner on Count I of the Amended Petition on the ground that Registrant’s Reservation Services are an unregistrable ancillary service such that the Amended Registration should be found void.

3. Registrant’s Reservation Services Are Not for Others Because Registrant Retains the Primary Benefit and Owns or Controls All of the Hotels for Which the Reservation Services Are Offered

Registrant’s claim of use of the Mark in connection with “making reservations of temporary lodging for others” is insufficient because the activity is for Registrant’s own benefit rather than “for others”. Therefore, summary judgment should be granted to Petitioner on the ground that Registrant has not used the Mark, and it has been abandoned.

The interpretation of the term “others” in the Reservation Services is the key to determining whether this service has been performed by Registrant. There are only two logical

constructions of this term. Either “others” means hotel customers who use Registrant’s website to make a reservation, or “others” means entities other than Registrant who operate hotel facilities at which the Lodging Services are provided. The first construction is incorrect as a matter of law, and the second construction is foreclosed by the undisputed factual record in this case. Accordingly, summary judgment should be granted to Petitioner on Count II of the Amended Petition.

The controlling question regarding whether an activity is for the benefit of “others” is who primarily benefits from the activity for which registration is sought. TMEP § 1301.01(a)(ii). While customers may receive some benefit from the activity, it is the party that *primarily* benefits that matters. *See In re Alaska Northwest Publ’g Co.*, 212 USPQ 316, 317 (TTAB 1981) (holding that fact “that the activities and operations associated with the production, advertising or sale of the product may be indirectly beneficial to purchasers of the product is immaterial to the question of registrability of the mark as a service mark”). By allowing customers to reserve a room at Registrant’s lodging facilities in advance, the Reservation Services induce the sale of Registrant’s Lodging Services. Accordingly, while customers may derive some benefit from the reservation activity, Registrant itself is the primary beneficiary because it derives sales of lodging services. Thus, any argument by Registrant that customers are the “others” for whom it is providing the Reservation Services is unsupported by the law.

Therefore, Registrant can be using the Reservation Services only if the “others” comprise third-parties other than Registrant or its customers. This, however, is not the case. According to information provided by Registrant in discovery, [REDACTED]

[REDACTED]

[REDACTED]

Because goodwill established in the minds of the relevant buying public is protected by a registration of a service mark and a segment of the public “purchases” and “benefits” from a service provided by the owner of the mark, the determinative question in whether an activity is “for others” is whether the benefiting party can be considered members of a “public.” *In re Canadian Pacific Ltd.*, 754 F.2d 992 (Fed. Cir. 1985). In *Canadian Pacific*, the Trademark Examining attorney refused to register the applicant’s mark on the ground that the applicant was not performing a “service” within the meaning of § 45 of the Trademark Act. *Id.* The applicant’s wholly-owned subsidiary owned an investment portfolio of marketable securities. In connection with its portfolio, the subsidiary established a “Shareholder Dividend Reinvestment and Share Purchase Plan” (“Plan”). The Plan set out a system for reinvestment of dividends in new common shares of the subsidiary available only to those persons who already own common shares of the subsidiary. However, because the Plan was available only to the subsidiaries’ own stockholders in connection with their further investment or participation in the subsidiaries’ own activities, the court found that no person or entity “other” than the subsidiaries and its 75% parent (the applicant) was involved, so that there was no “public” to which (or to whom) the asserted service mark could be directed and be useful. The court stated that “[the subsidiaries’] shareholders are, in fact and in law, its owners, i.e., all together they are [the subsidiary], and there is no other such owner.” *Id.*

In this case, since it is Registrant or its subsidiaries that operate the hotels, when Registrant engages in reservation activities it is merely offering to reserve rooms at its own hotels. The benefiting party, Registrant, directly and through its subsidiaries, cannot be considered members of a “public.” Registrant’s claimed reservation activities are clearly for its

own benefit and not “for others” as required for it to be providing the service as claimed in the Amended Registration.

[REDACTED]
[REDACTED]
[REDACTED]. Registrant has not been providing its claimed service of “making reservations of temporary lodging *for others*,” and thus Petitioner should be granted summary judgment on Count II of the Amended Petition on the ground of abandonment.

IV. CONCLUSION

For all the foregoing reasons, Petitioner respectfully requests that the Board grant its motion to amend the Petition to Cancel in the above-captioned cancellation proceeding, and that the Board grant its Motion for Summary Judgment on Counts I and II of the amended Petition.

Respectfully submitted,

Dated:



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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Motion for Leave to Amend and for Summary Judgment, and Memorandum in Support thereof, along with all exhibits thereto, was served on this 17th day of July, 2015, by electronic mail, on:

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EXHIBIT A-1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

G6 HOSPITALITY IP LLC

Petitioner,

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MOTEL ONE GMBH,

Registrant.

Cancellation No. 92057877

Trademark Registration No. 3,505,545

Mark: MOTEL ONE (& Design)

Date Registered: September 23, 2008

AMENDED PETITION TO CANCEL

G6 Hospitality IP LLC (“Petitioner”) is a Delaware limited liability company with a business address at 4001 International Parkway, Carrollton, Texas 75007. To the best of Petitioner’s knowledge, the owner of U.S. Trademark Registration No. 3,505,545, which was amended on or about August 14, 2014 (the “Amended Registration”) for the mark MOTEL ONE (& Design) (“MOTEL ONE Mark”) is Motel One GmbH, a German company (“Registrant”) with a business address of Theatinerstrasse 16, D-80333 Munchen, Germany. Petitioner believes that it is damaged by the Amended Registration and petitions to cancel it as set forth below.

BACKGROUND

1. Since at least as early as January 1965, Petitioner and its predecessors in interest have used, and still presently use, the mark MOTEL 6 alone or with design elements (collectively, “MOTEL 6 Mark(s)”) in connection with motel services and hotel services, and making reservations for the same for the benefit of its franchisees, (“Petitioner’s Services”) in the United States.

2. Petitioner’s MOTEL 6 Mark is a household name with respect to Petitioner’s Services and the hospitality industry.

3. Petitioner provides Petitioner’s Services in the United States and Canada and currently has approximately 1,100 locations with more than 105,000 rooms.

4. Advertising Age magazine has recognized Petitioner’s *We’ll Leave the Light on for You* advertising campaign, used in connection with Petitioner’s Services, as one of the top advertising campaigns in the last 100 years and Petitioner was the only lodging or temporary accommodations provider to earn this distinction.

5. Since at least as early as May 4, 2000, Petitioner’s customers have been able to make reservations for Petitioner’s Services and Petitioner’s franchisees’ temporary accommodation facilities using Petitioner’s website. Prior to that time and to date, Petitioner’s customers have been able to make reservations for Petitioner’s Services and Petitioner’s franchisees’ temporary accommodation facilities using the telephone.

6. Petitioner is the owner of several incontestable trademark registrations for the MOTEL 6 Marks including Reg. Nos., 1,816,233; 0,822,563; 1,589,489; 1,788,512; 2,198,435; 2,264,831; and 3,660,463 for use in connection with hotel and motel services (collectively, “Petitioner’s Registrations”).

7. Petitioner has invested substantial time, effort, and money in promoting Petitioner's Services provided in connection with the MOTEL 6 Marks.

8. The MOTEL 6 Marks are recognized as exclusively identifying Petitioner's Services and embody the goodwill and reputation that Petitioner has developed by continuously using the MOTEL 6 Marks over the past fifty (50) years.

9. On July 10, 2007 ("Registrant's Filing Date"), Registrant filed an application, Serial Number 79/044,672, ("Application") with the U.S. Patent and Trademark Office ("USPTO") for the MOTEL ONE Mark, for use in connection with "*professional business consulting services for catering and accommodation enterprises, including technical assistance in the establishment and operation of catering and accommodation businesses; consulting services for business management, planning and supervision of catering and accommodation enterprises; franchising of catering enterprises, namely, offering business know-how concerning the establishment and/or operation of catering and accommodation enterprises*" in international class 35 and "*providing temporary accommodation; catering services; making reservations of temporary lodging for others; technical consulting, namely, computer consultation in connection with catering and temporary accommodation enterprises*" in international class 42 ("Registrant's Services").

10. The Application that resulted in the Amended Registration was filed under Section 66(a) of the Trademark Act, 15 U.S.C. §1141(f), wherein Registrant declared that it possessed a bona fide intent to use the MOTEL ONE Mark in connection with all of Registrant's Services in commerce in the United States.

11. The original Registration issued on September 23, 2008.

12. The original Registration was fewer than five years old and was therefore subject to cancellation under Section 14(1) of the Lanham Act, 15 U.S.C. §1064 at the time the original Petition to Cancel in this matter was filed on September 16, 2013.

13. On or about July 25, 2014, following institution of this proceeding, Registrant filed a Declaration of Continued Use under Section 71, which deleted all the services in Class 35 in the original Registration, as well as all services in Class 42, with the exception of “making reservations of temporary lodging for others” (the “Reservation Services”). The specimens included with Registrant’s Declaration comprised two screen captures from Registrant’s website offering the Reservation Services.

14. Registrant does not currently provide hotel or temporary lodging services in the United States.

15. The Reservation Services provided by Registrant in the United States pertain exclusively to temporary lodging services offered outside the United States.

16. During discovery in this proceeding, which is still ongoing, Petitioner has learned that every entity through which Registrant provides temporary lodging services outside the United States is majority owned by Registrant or a subsidiary of Registrant.

COUNT I

VOID AB INITIO -- NON-REGISTRABLE ANCILLARY SERVICES

17. Petitioner re-alleges and incorporates by reference paragraphs 1 through 16 of this Amended Petition to Cancel as if fully set forth herein.

18. The Reservation Services offered by Registrant in association with its mark are services necessarily performed in association with the providing of temporary lodging services for its own facilities and are thus ancillary to those services.

19. The Reservation Services are not sufficiently distinct from the service of providing temporary lodging services at one's own facilities.

20. The Reservation Services, which are the only services recited in the Amended Registration, are thus not separately registrable as applied to Registrant's own facilities, and the Amended Registration is therefore void.

COUNT II

ABANDONMENT

21. Petitioner re-alleges and incorporates by reference paragraphs 1 through 20 of this Amended Petition to Cancel as if fully set forth herein.

22. Registrant's Reservation Services are offered on behalf of itself and its affiliates, and are not "for others" as set forth in the Amended Registration.

23. Registrant thus has not offered the Reservation Services recited in the Amended Registration.

24. Registrant thus has not used the mark in the United States in connection with the Reservation Services.

25. Upon information and belief, Registrant is not currently using the MOTEL ONE Mark in commerce in the United States in connection with the Reservation Services.

26. Upon information and belief, Registrant has not used the MOTEL ONE Mark in commerce in the United States in connection with the Reservation Services for at least the last three years.

27. Upon information and belief, Registrant has no intent to commence or to resume use of the MOTEL ONE Mark in commerce in the United States in connection with the Reservation Services.

28. Upon information and belief, the MOTEL ONE Mark set forth in the Amended Registration has been abandoned due to nonuse.

COUNT III

LACK OF BONA FIDE INTENT TO USE

29. Petitioner re-alleges and incorporates by reference paragraphs 1 through 28 of this Amended Petition to Cancel as if fully set forth herein.

30. Upon information and belief, as of the filing date of the Application, Registrant did not have a bona fide intent to use the MOTEL ONE Mark in commerce in the United States in connection with the Reservation Services.

COUNT IV

LIKELIHOOD OF CONFUSION

31. Petitioner re-alleges and incorporates by reference paragraphs 1 through 30 of this Amended Petition to Cancel as if fully set forth herein.

32. Petitioner and its predecessors-in-interest have used the MOTEL 6 Mark in connection with Petitioner's Services for forty-two (42) years before Registrant's Filing Date.

33. Petitioner and its predecessors-in-interest have used the MOTEL 6 Mark in connection with making reservations for Petitioner's Services and Petitioner's franchisees' temporary accommodation facilities prior to any date that Registrant can rely on.

34. Both the MOTEL ONE Mark and MOTEL 6 Marks begin with the word "MOTEL."

35. Both the MOTEL ONE Mark and MOTEL 6 Marks contain a single digit number directly after the word "MOTEL."

36. The MOTEL ONE Mark is confusingly similar to the MOTEL 6 Marks.

37. Registrant's Reservation Services are identical to Petitioner's Services, with the exception that Petitioner provides its Reservation Services for the benefit of its franchises ("others"), whereas Registrant's Reservation Services are only for its own benefit and not for others.

38. The Amended Registration damages Petitioner by interfering with Petitioner's exclusive right to use and enforce the MOTEL 6 Marks in connection with Petitioner's Services.

39. Because the MOTEL ONE Mark and MOTEL 6 Marks are confusingly similar, and Registrant's Services and Petitioner's Services are identical or are very closely related, the MOTEL ONE Mark is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe, incorrectly, that Registrant's Services emanate from, are authorized or endorsed by, or are otherwise connected with Petitioner in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

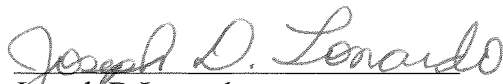
* * *

WHEREFORE, Petitioner prays that The Trademark Trial and Appeal Board sustain this Petition and cancel the Amended Registration No. 3,505,545 for the MOTEL ONE Mark.

The required fee accompanies this Petition to Cancel. Please charge any additional fees to Deposit Account No. 22-0585.

Please recognize Joseph D Lonardo, Cory M. Amron, William H. Oldach III, and Tanya Marie Curcio, all members of the bar of the District of Columbia, and all of the firm of Vorys, Sater, Seymour and Pease, LLP, as Petitioner's attorneys to prosecute this Amended Petition to Cancel.

Date: July 17, 2015



Joseph D Lonardo
Tanya Marie Curcio
Cory M. Amron
William H. Oldach III
VORYS, SATER, SEYMOUR & PEASE LLP
1909 K Street, NW
Ninth Floor
Washington, DC 20006
Telephone: 202.467.8800
E-Mail: iplaw@vorys.com

Attorneys for Petitioner
G6 Hospitality IP LLC

EXHIBIT A-2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

G6 HOSPITALITY IP LLC

Petitioner,

v.

MOTEL ONE GMBH,

Registrant.

Cancellation No. 92057877

Trademark Registration No. 3,505,545

Mark: MOTEL ONE (& Design)

Date Registered: September 23, 2008

AMENDED PETITION TO CANCEL

G6 Hospitality IP LLC (“Petitioner”) is a Delaware limited liability company with a business address at 4001 International Parkway, Carrollton, Texas 75007. To the best of Petitioner’s knowledge, the owner of U.S. Trademark Registration No. ~~3,505,545~~3,505,545, which was amended on or about August 14, 2014 (the “Amended Registration”) for the mark MOTEL ONE (& Design) (“MOTEL ONE Mark”) is Motel One GmbH, a German company (“Registrant”) with a business address of Theatinerstrasse 16, D-80333 Munchen, Germany. Petitioner believes that it is damaged by the Amended Registration and petitions to cancel it as set forth below.

BACKGROUND

1. Since at least as early as January ~~1965~~1965, Petitioner and its predecessors in interest have used, and still presently use, the mark MOTEL 6 alone or with design elements (collectively, “MOTEL 6 Mark(s)”) in connection with motel services and hotel services, and making reservations for the same for the benefit of its franchisees, (“Petitioner’s Services”) in the United States.

2. ~~Petitioners’~~Petitioner’s MOTEL 6 Mark is a household name with respect to Petitioner’s Services and the hospitality industry.

3. Petitioner provides Petitioner’s Services in the United States and Canada and currently has approximately 1,100 locations with more than 105,000 rooms.

4. Advertising Age magazine has recognized Petitioner’s *We’ll Leave the Light on for You* advertising campaign, used in connection with Petitioner’s Services, as one of the top advertising campaigns in the last 100 years and Petitioner was the only lodging or temporary accommodations provider to earn this distinction.

5. Since at least as early as May 4, 2000, Petitioner’s customers have been able to make reservations for Petitioner’s Services and Petitioner’s franchisees’ temporary accommodation facilities using Petitioner’s website. Prior to that time and to date, Petitioner’s customers have been able to make reservations for Petitioner’s Services and Petitioner’s franchisees’ temporary accommodation facilities using the telephone.

6. Petitioner is the owner of several incontestable trademark registrations for the MOTEL 6 Marks including Reg. Nos., 1,816,233; 0,822,563; 1,589,489; 1,788,512; 2,198,435; 2,264,831-
~~for use in connection with “motel services” and Petitioner is also the owner of trademark~~

~~registration No. and 3,660,463 for the MOTEL 6 Mark for use in connection with “hotel and motel services”~~ (collectively, “Petitioner’s Registrations”).

7. Petitioner has invested substantial time, effort, and money in promoting Petitioner’s Services provided in connection with the MOTEL 6 Marks.

8. The MOTEL 6 Marks are recognized as exclusively identifying Petitioner’s Services and embody the goodwill and reputation that Petitioner has developed by continuously using the MOTEL 6 Marks over ~~almost~~the past fifty (50) years.

9. On July 10, 2007 (“Registrant’s Filing Date”), Registrant filed an application, Serial Number 79/044,672, (“Application”) with the U.S. Patent and Trademark Office (“USPTO”) for the MOTEL ONE Mark, for use in connection with “*professional business consulting services for catering and accommodation enterprises, including technical assistance in the establishment and operation of catering and accommodation businesses; consulting services for business management, planning and supervision of catering and accommodation enterprises; franchising of catering enterprises, namely, offering business know-how concerning the establishment and/or operation of catering and accommodation enterprises*” in international class 35 and “*providing temporary accommodation; catering services; making reservations of temporary lodging for others; technical consulting, namely, computer consultation in connection with catering and temporary accommodation enterprises*” in international class 42 (“Registrant’s Services”).

10. The Application that resulted in the Amended Registration was filed under Section 66(a) of the Trademark Act, 15 U.S.C. §1141(f), wherein~~the~~ Registrant declared that it possessed a bona fide intent to use the MOTEL ONE Mark in connection with all of~~the~~ Registrant’s Services in commerce in the United States.

11. The original Registration issued on September 23, 2008.

12. The original Registration ~~is~~was fewer than five years old and ~~is~~was therefore subject to cancellation under Section 14(1) of the Lanham Act, 15 U.S.C. §~~1064~~1064 at the time the original Petition to Cancel in this matter was filed on September 16, 2013.

13. On or about July 25, 2014, following institution of this proceeding, Registrant filed a Declaration of Continued Use under Section 71, which deleted all the services in Class 35 in the original Registration, as well as all services in Class 42, with the exception of “making reservations of temporary lodging for others” (the “Reservation Services”). The specimens included with Registrant’s Declaration comprised two screen captures from Registrant’s website offering the Reservation Services.

14. Registrant does not currently provide hotel or temporary lodging services in the United States.

15. The Reservation Services provided by Registrant in the United States pertain exclusively to temporary lodging services offered outside the United States.

16. During discovery in this proceeding, which is still ongoing, Petitioner has learned that every entity through which Registrant provides temporary lodging services outside the United States is majority owned by Registrant or a subsidiary of Registrant.

COUNT I

VOID AB INITIO -- NON-REGISTRABLE ANCILLARY SERVICES

17. Petitioner re-alleges and incorporates by reference paragraphs 1 through 16 of this Amended Petition to Cancel as if fully set forth herein.

18. The Reservation Services offered by Registrant in association with its mark are services necessarily performed in association with the providing of temporary lodging services for its own facilities and are thus ancillary to those services.

19. The Reservation Services are not sufficiently distinct from the service of providing temporary lodging services at one's own facilities.

20. The Reservation Services, which are the only services recited in the Amended Registration, are thus not separately registrable as applied to Registrant's own facilities, and the Amended Registration is therefore void.

COUNT II

ABANDONMENT

21. ~~13.~~ Petitioner re-alleges and incorporates by reference paragraphs 1 through ~~12, 20~~ of this Amended Petition to Cancel as if fully set forth herein.

22. Registrant's Reservation Services are offered on behalf of itself and its affiliates, and are not "for others" as set forth in the Amended Registration.

23. Registrant thus has not offered the Reservation Services recited in the Amended Registration.

24. Registrant thus has not used the mark in the United States in connection with the Reservation Services.

25. ~~14.~~ Upon information and belief, Registrant has never used and is not currently using the MOTEL ONE Mark in commerce in the United States in connection with the Reservation Services.

~~15. Upon information and belief, Registrant has never operated a hotel, motel or any temporary accommodations or lodging facility ("Hotel Services") in the United States.~~

~~16. Upon information and belief, Registrant has never provided the service of making reservations of temporary lodging for others ("Reservation Services") in the United States.~~

~~17. Upon information and belief, Registrant has never provided: professional business consulting services for catering and accommodation enterprises, including technical assistance in the establishment and operation of catering and accommodation businesses; consulting services for business management, planning and supervision of catering and accommodation enterprises; franchised catering enterprises, namely, offering business know-how concerning the establishment and/or operation of catering and accommodation enterprises, technical consulting services, namely, computer consultation in connection with catering and temporary accommodation enterprises (“Consulting Services”) in the United States.~~

~~18. Upon information and belief, Registrant has never provided catering services (“Catering Services”) in the United States.~~

~~26. 19.~~ Upon information and belief, Registrant has not used the MOTEL ONE Mark in commerce in the United States in connection with ~~any of Registrant’s~~ the Reservation Services for at least the last three years.

~~27. 20.~~ Upon information and belief, Registrant has no intent to commence or to resume use of the MOTEL ONE Mark in commerce in the United States in connection with the Reservation Services.

~~28. 21.~~ Upon information and belief, the MOTEL ONE Mark set forth in the Amended Registration has been abandoned due to nonuse.

COUNT II
COUNT III

LACK OF BONA FIDE INTENT TO USE

~~29. 22.~~ Petitioner re-alleges and incorporates by reference paragraphs 1 through ~~21-28~~ of this Amended Petition to Cancel as if fully set forth herein.

30. ~~23.~~ Upon information and belief, as of the filing date of the Application ~~the~~ Registrant did not have a bona fide intent to use the MOTEL ONE Mark in commerce in the United States in connection with Registrant's the Reservation Services.

COUNT III

COUNT IV

LIKELIHOOD OF CONFUSION

31. ~~24.~~ Petitioner re-alleges and incorporates by reference paragraphs 1 through ~~12.~~30 of this Amended Petition to Cancel as if fully set forth herein.

32. ~~25.~~ Petitioner and its predecessors-in-interest have used the MOTEL 6 Mark in connection with Petitioner's Services for forty-two (42) years before Registrant's Filing Date.

33. ~~26.~~ Petitioner and its predecessors-in-interest have used the MOTEL 6 Mark in connection with making reservations for Petitioner's Services and Petitioner's franchisees' temporary accommodation facilities prior to any date that Registrant can rely on.

34. ~~27.~~ Both the MOTEL ONE Mark and MOTEL 6 Marks begin with the word "MOTEL."

35. ~~28.~~ Both the MOTEL ONE Mark and MOTEL 6 Marks contain a single digit number directly after the word "MOTEL."

36. ~~29.~~ The MOTEL ONE Mark is confusingly similar to the MOTEL 6 Marks.

30. ~~Registrant's Hotel Services are identical to Petitioner's Services.~~

37. ~~31.~~ Registrant's Reservation Services are identical to Petitioner's Services.

32. ~~Registrant's Catering Services are very closely related to Petitioner's Services.~~

33. ~~Registrant's Consulting Services are very closely related to Petitioner's Services.~~ with the exception that Petitioner provides its Reservation Services for the benefit of its franchises

(“others”). whereas Registrant’s Reservation Services are only for its own benefit and not for others.

38. ~~34.~~ The Amended Registration damages Petitioner by interfering with Petitioner’s exclusive right to use and enforce the MOTEL 6 Marks in connection with ~~the~~ Petitioner’s Services.

39. ~~35.~~ Because the MOTEL ONE Mark and MOTEL 6 Marks are confusingly similar, ~~and the~~ Registrant’s Services and Petitioner’s Services are identical or are very closely related, the MOTEL ONE Mark is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe, incorrectly, that Registrant’s Services emanate from, are authorized or endorsed by, or are otherwise connected with Petitioner in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

* * *

WHEREFORE, Petitioner prays that The Trademark Trial and Appeal Board sustain this Petition and cancel the Amended Registration No. 3,505,545 for the MOTEL ONE Mark.

The required fee accompanies this Petition to Cancel. Please charge any additional fees to Deposit Account No. 22-0585.

Please recognize Joseph D. Lonardo, Cory M. Amron, William H. Oldach III, ~~Christopher M. Ott~~ and Tanya Marie Curcio, all members of the bar of the District of Columbia, and ~~Tanya Marie Curcio~~, a member of the bar of the State of New York, and all of the firm of Vorys, Sater, Seymour and Pease, LLP, as Petitioner's attorneys to prosecute this Amended Petition to Cancel.

Respectfully submitted, -

Date: ~~September 16, 2013~~ July 17, 2015

Joseph D. Lonardo
Tanya Marie Curcio
Cory M. Amron
William H. Oldach III
~~Christopher M. Ott~~
VORYS, SATER, SEYMOUR & PEASE LLP
1909 K Street, NW
Ninth Floor
Washington, DC 20006
Telephone: 202.467.8800
E-Mail: iplaw@vorys.com

~~Attorney~~ Attorneys for Petitioner
G6 Hospitality IP LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petition to Cancel has been served on Motel One GmbH by mailing said copy on this 16th day of September 2013, via Federal Express International, postage prepaid to:—

President
Motel One GmbH
Theatinerstrasse 16 80333 München
Federal Republic of Germany

I hereby certify that a true and complete copy of the foregoing Petition to Cancel has been served on James H. Johnson Jr. Esq. by mailing said copy on this 16th day of September 2013, via First Class Mail, postage prepaid to:—

James H. Johnson Jr.
Sutherland Asbill & Brennan LLP
999 Peachtree Street NE
Atlanta, GA 30309-3996
United States

Tanya Marie Curcio

EXHIBIT B

Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71

The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	3505545
REGISTRATION DATE	09/23/2008
SERIAL NUMBER	79044672
MARK SECTION	
MARK	MOTEL ONE (stylized and/or with design)
ATTORNEY SECTION (new)	
NAME	David H. Bernstein, Esq.
FIRM NAME	Debevoise & Plimpton LLP
STREET	919 Third Ave.
CITY	New York
STATE	New York
POSTAL CODE	10022
COUNTRY	United States
PHONE	2129096000
EMAIL	trademarks@debevoise.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
OTHER APPOINTED ATTORNEY	Zheng Wang, Esq.
CORRESPONDENCE SECTION (current)	
FIRM NAME	MOTEL ONE GMBH

STREET	THEATINERSTRASSE 16
CITY	80333 MÜNCHEN
COUNTRY	Germany
CORRESPONDENCE SECTION (proposed)	
NAME	David H. Bernstein, Esq.
FIRM NAME	Debevoise & Plimpton LLP
STREET	919 Third Ave.
CITY	New York
STATE	New York
POSTAL CODE	10022
COUNTRY	United States
PHONE	2129096000
EMAIL	trademarks@debevoise.com;dhbernstein@debevoise.com;zwang@debevoise.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	035
GOODS OR SERVICES	DELETE ENTIRE CLASS
INTERNATIONAL CLASS	042
GOODS OR SERVICES TO BE DELETED	Providing temporary accommodation; catering services; technical consulting, namely, computer consultation in connection with catering and temporary accommodation enterprises
GOODS OR SERVICES IN USE IN COMMERCE OR FOR WHICH OWNER CLAIMS EXCUSABLE NONUSE	Making reservations of temporary lodging for others
SPECIMEN FILE NAME(S)	<u>\\TICRS\EXPORT16\IMAGEOUT 16\790\446\79044672\xml2\ S710002.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT 16\790\446\79044672\xml2\ S710003.JPG</u>
SPECIMEN DESCRIPTION	Screenshots of registrant's website offering hotel reservation services

OWNER/HOLDER SECTION (current)	
NAME	Motel One GmbH
STREET	Theatinerstrasse 16
COUNTRY	Germany
OWNER SECTION (proposed)	
NAME	Motel One GmbH
STREET	Theatinerstrasse 16
CITY	Munich
COUNTRY	Germany
LEGAL ENTITY SECTION (current)	
TYPE	APPLICANT ENTERED NO DATA
LEGAL ENTITY SECTION (proposed)	
TYPE	gesellschaft mit beschränkter haftung (gmbh)
STATE/COUNTRY WHERE LEGALLY ORGANIZED	Germany
PAYMENT SECTION	
NUMBER OF CLASSES	2
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	100
TOTAL FEE PAID	100
SIGNATURE SECTION	
SIGNATURE	/stefan.lenze/
SIGNATORY'S NAME	Stefan Lenze
SIGNATORY'S POSITION	Director
DATE SIGNED	07/24/2014
PAYMENT METHOD	DA
FILING INFORMATION	
SUBMIT DATE	Fri Jul 25 12:34:42 EDT 2014

TEAS STAMP

USPTO/SECT71-208.201.160.
2-20140725123442979684-35
05545-5008fdb78dab5ff1486
257cc5346e39bfa05ac52e507
3c1e84c40fa9b16864bbfcd-D
A-9070-201407241552138191
08

Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71

To the Commissioner for Trademarks:

REGISTRATION NUMBER: 3505545

REGISTRATION DATE: 09/23/2008

MARK: (Stylized and/or with Design, MOTEL ONE)

The owner/holder, Motel One GmbH, gesellschaft mit beschränkter haftung (gmbh) legally organized under the laws of Germany, having an address of

Theatinerstrasse 16

Munich,

Germany

is filing a Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71.

For International Class 035, this filing does **not** cover this specific class. This entire class is to be **deleted** from the registration. The USPTO will invalidate protection of this class and notify the International Bureau accordingly

For International Class 042, this filing does **NOT** cover the following goods or services for this specific class listed in the registered extension of protection, and these goods or services are to be permanently **deleted (removed)** from the registration: Providing temporary accommodation; catering services; technical consulting, namely, computer consultation in connection with catering and temporary accommodation enterprises

The mark is in use in commerce on or in connection with the following goods/services, or to indicate membership in the collective membership organization, listed in the existing registered extension of protection for this specific class; or, the owner is making the listed excusable nonuse claim: Making reservations of temporary lodging for others

The owner is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) Screenshots of registrant's website offering hotel reservation services.

Specimen File1

Specimen File2

The registrant's current Correspondence Information: of MOTEL ONE GMBH

THEATINERSTRASSE 16

80333 MÜNCHEN,

Germany

The registrant's proposed Correspondence Information: David H. Bernstein, Esq. of Debevoise & Plimpton LLP

919 Third Ave.
New York, New York (NY) 10022
United States

The phone number is 2129096000.

The email address is trademarks@debevoise.com;dhbernstein@debevoise.com;zwang@debevoise.com.
The registrant hereby appoints David H. Bernstein, Esq. and Zheng Wang, Esq. of Debevoise & Plimpton LLP

919 Third Ave.
New York, New York 10022
United States

to submit this Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 on behalf of the registrant.

The phone number is 2129096000.

The email address is trademarks@debevoise.com.

A fee payment in the amount of \$100 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

Declaration

Unless the owner/holder has specifically claimed excusable nonuse, the mark is in use in commerce on or in connection with the goods/services, or to indicate membership in the collective membership organization identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of this submission, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Signature: /stefan.lenze/ Date: 07/24/2014
Signatory's Name: Stefan Lenze
Signatory's Position: Director

Mailing Address:
Debevoise & Plimpton LLP
919 Third Ave.
New York, New York 10022

Serial Number: 79044672
Internet Transmission Date: Fri Jul 25 12:34:42 EDT 2014
TEAS Stamp: USPTO/SECT71-208.201.160.2-2014072512344

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fcd-DA-9070-20140724155213819108

HAMBURG-AIRPORT

SHARE

HOTELINFO

LOCATION & SURROUNDING AREA

REVIEWS

GALLERY

EVENTS

Arrival: 03.05.2014
Departure: 04.05.2014

Rooms: 01
Guests: 01
AVAILABLE

PRICE PER ROOM/ROOM FROM 61,14€

BOOK

ONE REVIEW
98%
98% of our guests would recommend this hotel out of a total Review of 3043 Reviews.

- ✓ Check-in 03.00 p.m.
- ✓ Breakfast buffet 7.50 €
- ✓ Reception open 24 hours

Further Rates

Address & Contact

Alsterkrugchaussee 455-459
22335 Hamburg

Phone: +49 40 533 01 93-0
Fax: +49 40 533 01 93-10

hamburg-airport@motel-one.com

Contact us!

- ✓ Best rate guarantee
- ✓ Easy & secure booking
- ✓ Rates & availabilities in real time
- ✓ Booking without credit card*
- ✓ Free cancellation up to 6 pm*
- ✓ Prompt confirmation by e-mail

*Does not apply during trade fair and event times



Motel One wins test award in 2014



96,48% of our guests would recommend Motel One! (113.914 customer evaluations)

your online BENEFITS

- ✓ Best rate guarantee
- ✓ Easy & secure booking
- ✓ Rates & availabilities in real time
- ✓ Booking without credit card*
- ✓ Free cancellation up to 6 pm*
- ✓ Prompt confirmation by e-mail

*does not apply during trade fair and event times



Motel One wins test award in 2014



96.48 % of our guests would recommend Motel One!
(113,914 customer evaluations)

HAMBURG-AIRPORT

SHARE

HOTELINFO

LOCATION & SURROUNDING AREA

REVIEWS

GALLERY

EVENTS

WELCOME TO HAMBURG



Willkommen bei Motel One

ROUTING SHEET TO POST REGISTRATION (PRU)

Registration Number: 3505545



Serial Number: 79044672



RAM Sale Number: 3505545

RAM Accounting Date: 20140725

Total Fees: \$100

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

Physical Location: - UNKNOWN

Lost Case Flag: False

In TICS (AM-FLG-IN-TICS): True

Transaction Date: 20140725



EXHIBIT C

Trademark/Service Mark Application, Principal Register

Serial Number: 86368963

Filing Date: 08/18/2014

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86368963
MARK INFORMATION	
*MARK	<u>MOTEL ONE</u>
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	MOTEL ONE
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Motel One GmbH
*STREET	Tegernseer Landstrasse 165
*CITY	81539 Munich
*COUNTRY	Germany
LEGAL ENTITY INFORMATION	
TYPE	gesellschaft mit beschränkter haftung (gmbh)
STATE/COUNTRY WHERE LEGALLY ORGANIZED	Germany
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	042
*IDENTIFICATION	Providing temporary accommodation; catering services
FILING BASIS	SECTION 1(b)

ADDITIONAL STATEMENTS SECTION	
PRIOR REGISTRATION(S)	The applicant claims ownership of U.S. Registration Number(s) 3505545.
ATTORNEY INFORMATION	
NAME	James H. Johnson, Jr.
ATTORNEY DOCKET NUMBER	18744-0101
FIRM NAME	Sutherland Asbill & Brennan LLP
STREET	999 Peachtree Street NE
CITY	Atlanta
STATE	Georgia
COUNTRY	United States
ZIP/POSTAL CODE	30309-3996
PHONE	404-853-8395
FAX	404-853-8806
EMAIL ADDRESS	patent.docket@sutherland.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Peter G. Pappas, William L. Warren, Daniel J. Warren, Kevin W. King, and Christopher J. Chan
CORRESPONDENCE INFORMATION	
NAME	James H. Johnson, Jr.
FIRM NAME	Sutherland Asbill & Brennan LLP
STREET	999 Peachtree Street NE
CITY	Atlanta
STATE	Georgia
COUNTRY	United States
ZIP/POSTAL CODE	30309-3996
PHONE	404-853-8395
FAX	404-853-8806
EMAIL ADDRESS	patent.docket@sutherland.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	

NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325
SIGNATURE INFORMATION	
SIGNATURE	/stefan.lenze/
SIGNATORY'S NAME	Stefan Lenze
SIGNATORY'S POSITION	Director
DATE SIGNED	08/16/2014

Trademark/Service Mark Application, Principal Register

Serial Number: 86368963

Filing Date: 08/18/2014

To the Commissioner for Trademarks:

MARK: MOTEL ONE (Standard Characters, see mark)

The literal element of the mark consists of MOTEL ONE.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Motel One GmbH, a gesellschaft mit beschränkter haftung (gmbh) legally organized under the laws of Germany, having an address of

Tegernseer Landstrasse 165
81539 Munich
Germany

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 042: Providing temporary accommodation; catering services

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant claims ownership of U.S. Registration Number(s) 3505545.

The applicant's current Attorney Information:

James H. Johnson, Jr. and Peter G. Pappas, William L. Warren, Daniel J. Warren, Kevin W. King, and
Christopher J. Chan of Sutherland Asbill & Brennan LLP
999 Peachtree Street NE
Atlanta, Georgia 30309-3996
United States

The attorney docket/reference number is 18744-0101.

The applicant's current Correspondence Information:

James H. Johnson, Jr.
Sutherland Asbill & Brennan LLP
999 Peachtree Street NE
Atlanta, Georgia 30309-3996
404-853-8395(phone)

404-853-8806(fax)

patent.docket@sutherland.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /stefan.lenze/ Date: 08/16/2014

Signatory's Name: Stefan Lenze

Signatory's Position: Director

RAM Sale Number: 86368963

RAM Accounting Date: 08/18/2014

Serial Number: 86368963

Internet Transmission Date: Mon Aug 18 07:39:36 EDT 2014

TEAS Stamp: USPTO/BAS-64.202.223.178-201408180739363

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4-DA-6929-20140814102944556081

MOTEL ONE

EXHIBIT D

To: Motel One GmbH (patent.docket@sutherland.com)

Subject: U.S. TRADEMARK APPLICATION NO. 86368963 - MOTEL ONE - 18744-0101

Sent: 12/11/2014 2:57:40 PM

Sent As: ECOM115@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86368963

MARK: MOTEL ONE

86368963

CORRESPONDENT ADDRESS: JAMES H. JOHNSON, JR. Sutherland Asbill Brennan 999 Peachtree St NE Ste 2300 Atlanta, GA 30309-3996	CLICK HERE TO RESPOND TO THIS LETTER http://www.uspto.gov/trademarks/teas/response VIEW YOUR APPLICATION FILE
APPLICANT: Motel One GmbH	
CORRESPONDENT'S REFERENCE/DOCKET NO : 18744-0101 CORRESPONDENT E-MAIL ADDRESS: patent.docket@sutherland.com	

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 12/11/2014

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Registration Refusal- Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. **Registration No. 3349279**. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of

the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

The applicant's mark is MOTEL ONE. The registrant's mark is ONE. The marks are similar in sound, appearance, and commercial impression because the marks share the term ONE.

Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

Similarity of the Goods/ Services

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i).

The respective goods and/or services need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

The applicant's goods/services are providing temporary accommodation; catering services. The registrant's goods/services are hotel services for preferred customers. The goods/services are related because entities that provide hotel services are providing temporary accommodation and do often also offer catering services.

The trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar

goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, namely providing temporary accommodation; catering services and hotel services are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Accordingly, registration is refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Prior Pending Application(s)

The filing dates of pending U.S. Application Serial Nos. **78926922; 78926965; 78927075; 86060308; 86060348; and 86060380** precede applicant's filing date. See attached referenced applications. If one or more of the marks in the referenced applications register, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s). *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the marks in the referenced applications. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

If applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

INFORMALITIES

Misclassification of Services

The services are classified incorrectly. Applicant must amend the application to classify the services in **International Class 43 rather than 42**. *See* 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b).

Disclaimer

Applicant must disclaim the wording "MOTEL" because it merely describes an ingredient, quality,

characteristic, function, feature, purpose, or use of applicant's goods and/or services, and thus is an unregistrable component of the mark. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

The attached evidence shows this wording refers to an establishment which provides lodging. Therefore, the wording merely describes the nature of the services being provided by the applicant.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace. *See Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant should submit a disclaimer in the following standardized format:

No claim is made to the exclusive right to use "MOTEL" apart from the mark as shown.

For an overview of disclaimers and instructions on how to satisfy this disclaimer requirement online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/disclaimer.jsp>.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney.

/Kathryn E. Coward/
Trademark Examining Attorney
U.S. Patent & Trademark Office
Law Office 115
(571)-272-9468
Kathryn.coward@uspto.gov

All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailling date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned

trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

Print: Dec 11, 2014

78926922

DESIGN MARK

Serial Number

78926922

Status

OPPOSITION PENDING

Word Mark

1 HOTEL

Standard Character Mark

No

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

SH GROUP GLOBAL IP HOLDINGS, L.L.C. LIMITED LIABILITY COMPANY DELAWARE
591 WEST PUTNAM AVENUE GREENWICH CONNECTICUT 06830

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: NIGHT CLUB SERVICES; HEALTH CLUB SERVICES, NAMELY, PROVIDING INSTRUCTION AND EQUIPMENT IN THE FIELD OF PHYSICAL EXERCISE; LEISURE CLUB SERVICES, NAMELY, COUNTRY CLUB AND GOLF CLUB SERVICES; PROVISION OF SPORT AND RECREATIONAL FACILITIES.

Goods/Services

Class Status -- ACTIVE. IC 043. US 100 101. G & S: HOTELS; CONDOMINIUM HOTELS; HOTEL SERVICES; RESORT HOTEL SERVICES; SPA SERVICES, NAMELY, PROVIDING TEMPORARY ACCOMMODATIONS AND MEALS TO CLIENTS OF A HEALTH OR BEAUTY SPA; RESTAURANTS; BARS; RESTAURANT AND BAR SERVICES.

Goods/Services

Class Status -- ACTIVE. IC 036. US 100 101 102. G & S: LEASING, RENTAL, AND MANAGEMENT OF CONDOMINIUMS, APARTMENTS, VILLAS AND RESIDENTIAL HOMES; LEASING, RENTAL, AND MANAGEMENT OF CONDOMINIUMS, APARTMENTS, VILLAS AND RESIDENTIAL HOMES IN VACATION AND RESORT COMMUNITIES.

Goods/Services

Class Status -- ACTIVE. IC 044. US 100 101. G & S: HEALTH SPA SERVICES FOR HEALTH AND WELLNESS OF THE BODY AND SPIRIT OFFERED AT

Print: Dec 11, 2014

78926922

HEALTH RESORTS; HEALTH SPA SERVICES, NAMELY, COSMETIC BODY CARE SERVICES.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOTEL" APART FROM THE MARK AS SHOWN.

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

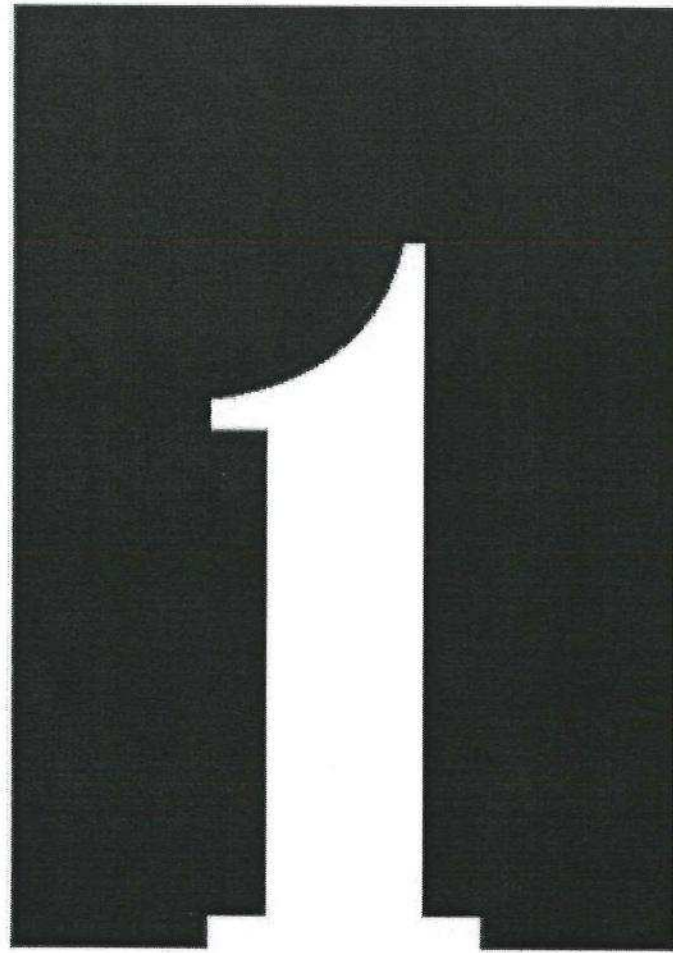
2006/07/11

Examining Attorney

SWIFT, GILBERT

Attorney of Record

Stephen G. Janoski



H O T E L



Print: Dec 11, 2014

78926965

DESIGN MARK

Serial Number

78926965

Status

OPPOSITION PENDING

Word Mark

1 HOTEL & RESIDENCES

Standard Character Mark

No

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

SH GROUP GLOBAL IP HOLDINGS, L.L.C. LIMITED LIABILITY COMPANY DELAWARE
591 WEST PUTNAM AVENUE GREENWICH CONNECTICUT 06830

Goods/Services

Class Status -- ACTIVE. IC 036. US 100 101 102. G & S: LEASING, RENTAL, AND MANAGEMENT OF CONDOMINIUMS, APARTMENTS, VILLAS AND RESIDENTIAL HOMES; LEASING, RENTAL, AND MANAGEMENT OF CONDOMINIUMS, APARTMENTS, VILLAS AND RESIDENTIAL HOMES IN VACATION AND RESORT COMMUNITIES.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: NIGHT CLUB SERVICES; HEALTH CLUB SERVICES, NAMELY, PROVIDING INSTRUCTION AND EQUIPMENT IN THE FIELD OF PHYSICAL EXERCISE; LEISURE CLUB SERVICES, NAMELY, COUNTRY CLUB AND GOLF CLUB SERVICES; PROVISION OF SPORT AND RECREATIONAL FACILITIES.

Goods/Services

Class Status -- ACTIVE. IC 043. US 100 101. G & S: HOTELS; CONDOMINIUM HOTELS; HOTEL SERVICES; RESORT HOTEL SERVICES; SPA SERVICES, NAMELY, PROVIDING TEMPORARY ACCOMMODATIONS AND MEALS TO CLIENTS OF A HEALTH OR BEAUTY SPA; RESTAURANTS; BARS; RESTAURANT AND BAR SERVICES.

Goods/Services

Class Status -- ACTIVE. IC 044. US 100 101. G & S: HEALTH SPA SERVICES FOR HEALTH AND WELLNESS OF THE BODY AND SPIRIT OFFERED AT

Print: Dec 11, 2014

78926965

HEALTH RESORTS; HEALTH SPA SERVICES, NAMELY, COSMETIC BODY CARE SERVICES.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOTEL & RESIDENCES" APART FROM THE MARK AS SHOWN.

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

2006/07/11

Examining Attorney

SWIFT, GILBERT

Attorney of Record

Stephen G. Janoski



HOTEL

& RESIDENCES



Print: Dec 11, 2014

78927075

DESIGN MARK

Serial Number

78927075

Status

OPPOSITION PENDING

Word Mark

1 HOTEL & RESIDENCES NEW YORK

Standard Character Mark

No

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

SH GROUP GLOBAL IP HOLDINGS, L.L.C. LIMITED LIABILITY COMPANY DELAWARE
591 WEST PUTNAM AVENUE GREENWICH CONNECTICUT 06830

Goods/Services

Class Status -- ACTIVE. IC 036. US 100 101 102. G & S: LEASING, RENTAL, AND MANAGEMENT OF CONDOMINIUMS, APARTMENTS, VILLAS AND RESIDENTIAL HOMES; LEASING, RENTAL, AND MANAGEMENT OF CONDOMINIUMS, APARTMENTS, VILLAS AND RESIDENTIAL HOMES IN VACATION AND RESORT COMMUNITIES.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: NIGHT CLUB SERVICES; HEALTH CLUB SERVICES, NAMELY, PROVIDING INSTRUCTION AND EQUIPMENT IN THE FIELD OF PHYSICAL EXERCISE; LEISURE CLUB SERVICES, NAMELY, COUNTRY CLUB AND GOLF CLUB SERVICES; PROVISION OF SPORT AND RECREATIONAL FACILITIES.

Goods/Services

Class Status -- ACTIVE. IC 043. US 100 101. G & S: HOTELS; CONDOMINIUM HOTELS; HOTEL SERVICES; RESORT HOTEL SERVICES; SPA SERVICES, NAMELY, PROVIDING TEMPORARY ACCOMMODATIONS AND MEALS TO CLIENTS OF A HEALTH OR BEAUTY SPA; RESTAURANTS; BARS; RESTAURANT AND BAR SERVICES.

Goods/Services

Class Status -- ACTIVE. IC 044. US 100 101. G & S: HEALTH SPA SERVICES FOR HEALTH AND WELLNESS OF THE BODY AND SPIRIT OFFERED AT

Print: Dec 11, 2014

78927075

HEALTH RESORTS; HEALTH SPA SERVICES, NAMELY, COSMETIC BODY CARE SERVICES.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOTEL & RESIDENCES NEW YORK" APART FROM THE MARK AS SHOWN.

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

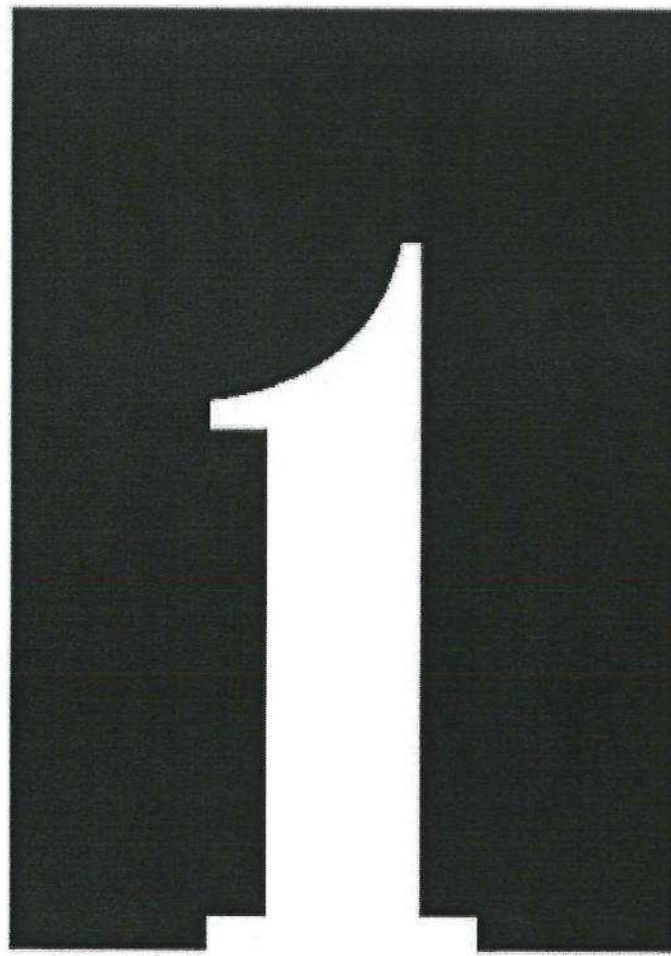
2006/07/11

Examining Attorney

SWIFT, GILBERT

Attorney of Record

Stephen G. Janoski



HOTEL
& RESIDENCES

NEW YORK

Print: Dec 11, 2014

78927101

DESIGN MARK

Serial Number

78927101

Status

SECOND EXTENSION - GRANTED

Word Mark

1 HOTEL & RESIDENCES SEATTLE

Standard Character Mark

No

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

SH GROUP GLOBAL IP HOLDINGS, L.L.C. LIMITED LIABILITY COMPANY DELAWARE
591 WEST PUTNAM AVENUE GREENWICH CONNECTICUT 06830

Goods/Services

Class Status -- ACTIVE. IC 036. US 100 101 102. G & S: LEASING, RENTAL, AND MANAGEMENT OF CONDOMINIUMS, APARTMENTS, VILLAS AND RESIDENTIAL HOMES; LEASING, RENTAL, AND MANAGEMENT OF CONDOMINIUMS, APARTMENTS, VILLAS AND RESIDENTIAL HOMES IN VACATION AND RESORT COMMUNITIES; REAL ESTATE BROKERAGE SERVICES.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: CASINOS, NAMELY, GAMBLING AND GAMING SERVICES; LIVE ENTERTAINMENT, NAMELY, LIVE PERFORMANCES BY MUSICAL BANDS AND LIVE COMEDY SHOWS; NIGHT CLUB SERVICES; HEALTH CLUB SERVICES, NAMELY, PROVIDING INSTRUCTION AND EQUIPMENT IN THE FIELD OF PHYSICAL EXERCISE; LEISURE CLUB SERVICES, NAMELY, COUNTRY CLUB AND GOLF CLUB SERVICES; PROVISION OF SPORT AND RECREATIONAL FACILITIES; ARRANGING AND CONDUCTING EDUCATIONAL CONFERENCES; ARRANGING AND CONDUCTING ENTERTAINMENT EXHIBITIONS IN THE NATURE OF COMEDY ACTS, DANCE ACTS, THEATER ACTS, PLAYS, STAGE PRODUCTIONS, MAGIC SHOWS, PERFORMANCE ART SHOWS; THEATRICAL BOOKING AGENCIES, NAMELY, THEATER, OPERA AND CONCERT TICKET RESERVATIONS.

Goods/Services

Class Status -- ACTIVE. IC 043. US 100 101. G & S: HOTELS; CONDOMINIUM HOTELS; HOTEL SERVICES; RESORT HOTEL SERVICES; SPA SERVICES, NAMELY, PROVIDING TEMPORARY ACCOMMODATIONS AND MEALS TO

CLIENTS OF A HEALTH OR BEAUTY SPA; RESTAURANTS; BARS; RESTAURANT AND BAR SERVICES.

Goods/Services

Class Status -- ACTIVE. IC 044. US 100 101. G & S: HEALTH SPA SERVICES FOR HEALTH AND WELLNESS OF THE BODY AND SPIRIT OFFERED AT HEALTH RESORTS; HEALTH SPA SERVICES, NAMELY, COSMETIC BODY CARE SERVICES.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOTEL & RESIDENCES SEATTLE" APART FROM THE MARK AS SHOWN.

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

2006/07/11

Examining Attorney

SWIFT, GILBERT

Attorney of Record

Stephen G. Janoski



H O T E L
& R E S I D E N C E S



S E A T T L E

Print: Dec 11, 2014

86060308

DESIGN MARK

Serial Number

86060308

Status

REQUEST FOR EXTENSION OF TIME TO FILE OPPOSITION

Word Mark

1 HOTEL & HOME

Standard Character Mark

No

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner

SH Group Global IP Holdings, L.L.C. LIMITED LIABILITY COMPANY DELAWARE
591 West Putnam Avenue Greenwich CONNECTICUT 06830

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Hotel management for others; business management and consultation in the hotel industry.

Goods/Services

Class Status -- ACTIVE. IC 036. US 100 101 102. G & S: Leasing, rental, and management of condominiums, apartments, villas and residential homes; leasing, rental, and management of condominiums, apartments, villas and residential homes in vacation and resort communities; real estate brokerage services.

Goods/Services

Class Status -- ACTIVE. IC 037. US 100 103 106. G & S: Real estate development, namely, hotel development for others; real estate development, namely, resort communities development for others; real estate development in the nature of hotel development and resort communities.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Casinos, namely, gambling and gaming services; live entertainment, namely, live performances by musical bands and live comedy shows; night club services; health club services, namely, providing instruction and

equipment in the field of physical exercise; leisure club services, namely, country club and golf club services; providing golf facilities; providing golf instruction and golf equipment; providing tennis facilities; providing tennis instruction and tennis equipment; ski resorts; providing skiing facilities; providing skiing instruction and skiing equipment; provision of sport and recreational facilities; arranging and conducting educational conferences; arranging and conducting entertainment exhibitions in the nature of comedy acts, dance acts, theater acts, plays, stage productions, magic shows, performance art shows; theatrical booking agencies, namely, theater, opera and concert ticket reservations.

Goods/Services

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Hotels; condominium hotels; hotel services; resort hotel services; spa services, namely, providing temporary accommodations and meals to clients of a health or beauty spa; restaurants; bars; restaurant and bar services.

Goods/Services

Class Status -- ACTIVE. IC 044. US 100 101. G & S: Health spa services for health and wellness of the body and spirit offered at health resorts; health spa services, namely, cosmetic body care services.

Prior Registration(s)

4226104;4226105;4226106

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOTEL & HOME" APART FROM THE MARK AS SHOWN.

Description of Mark

The mark consists of a numeral "1" located above the text "HOTEL & HOME".

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

2013/09/10

Examining Attorney

FRAZIER, TAMARA

Attorney of Record

Stephen G. Janoski

1

HOTEL & HOME

Print: Dec 11, 2014

86060348

DESIGN MARK

Serial Number

86060348

Status

REQUEST FOR EXTENSION OF TIME TO FILE OPPOSITION

Word Mark

1 HOTEL & HOMES

Standard Character Mark

No

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner

SH Group Global IP Holdings, L.L.C. LIMITED LIABILITY COMPANY DELAWARE
591 West Putnam Avenue Greenwich CONNECTICUT 06830

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Hotel management for others; business management and consultation in the hotel industry.

Goods/Services

Class Status -- ACTIVE. IC 036. US 100 101 102. G & S: Leasing, rental, and management of condominiums, apartments, villas and residential homes; leasing, rental, and management of condominiums, apartments, villas and residential homes in vacation and resort communities; real estate brokerage services.

Goods/Services

Class Status -- ACTIVE. IC 037. US 100 103 106. G & S: Real estate development, namely, hotel development for others; real estate development, namely, resort communities development for others; real estate development in the nature of hotel development and resort communities.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Casinos, namely, gambling and gaming services; live entertainment, namely, live performances by musical bands and live comedy shows; night club services; health club services, namely, providing instruction and

equipment in the field of physical exercise; leisure club services, namely, country club and golf club services; providing golf facilities; providing golf instruction and golf equipment; providing tennis facilities; providing tennis instruction and tennis equipment; ski resorts; providing skiing facilities; providing skiing instruction and skiing equipment; provision of sport and recreational facilities; arranging and conducting educational conferences; arranging and conducting entertainment exhibitions in the nature of comedy acts, dance acts, theater acts, plays, stage productions, magic shows, performance art shows; theatrical booking agencies, namely, theater, opera and concert ticket reservations.

Goods/Services

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Hotels; condominium hotels; hotel services; resort hotel services; spa services, namely, providing temporary accommodations and meals to clients of a health or beauty spa; restaurants; bars; restaurant and bar services.

Goods/Services

Class Status -- ACTIVE. IC 044. US 100 101. G & S: Health spa services for health and wellness of the body and spirit offered at health resorts; health spa services, namely, cosmetic body care services.

Prior Registration(s)

4226104;4226105;4226106

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOTEL & HOMES" APART FROM THE MARK AS SHOWN.

Description of Mark

The mark consists of a numeral "1" located above the text "HOTEL & HOMES".

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

2013/09/10

Examining Attorney

FRAZIER, TAMARA

Attorney of Record

Stephen G. Janoski

1

HOTEL & HOMES

Print: Dec 11, 2014

86060380

DESIGN MARK

Serial Number

86060380

Status

REQUEST FOR EXTENSION OF TIME TO FILE OPPOSITION

Word Mark

1 HOTEL & HOMES SOUTH BEACH

Standard Character Mark

No

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner

SH Group Global IP Holdings, L.L.C. LIMITED LIABILITY COMPANY DELAWARE
591 West Putnam Avenue Greenwich CONNECTICUT 06830

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Hotel management for others; business management and consultation in the hotel industry.

Goods/Services

Class Status -- ACTIVE. IC 036. US 100 101 102. G & S: Leasing, rental, and management of condominiums, apartments, villas and residential homes; leasing, rental, and management of condominiums, apartments, villas and residential homes in vacation and resort communities; real estate brokerage services.

Goods/Services

Class Status -- ACTIVE. IC 037. US 100 103 106. G & S: Real estate development, namely, hotel development for others; Real estate development, namely, resort communities development for others; real estate development in the nature of hotel development and resort communities.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Casinos, namely, gambling and gaming services; live entertainment, namely, live performances by musical bands and live comedy shows; night club services; health club services, namely, providing instruction and

equipment in the field of physical exercise; leisure club services, namely, country club and golf club services; providing golf facilities; providing golf instruction and golf equipment; providing tennis facilities; providing tennis instruction and tennis equipment; ski resorts; providing skiing facilities; providing skiing instruction and skiing equipment; provision of sport and recreational facilities; arranging and conducting educational conferences; arranging and conducting entertainment exhibitions in the nature of comedy acts, dance acts, theater acts, plays, stage productions, magic shows, performance art shows; theatrical booking agencies, namely, theater, opera and concert ticket reservations.

Goods/Services

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Hotels; condominium hotels; hotel services; resort hotel services; spa services, namely, providing temporary accommodations and meals to clients of a health or beauty spa; restaurants; bars; restaurant and bar services.

Goods/Services

Class Status -- ACTIVE. IC 044. US 100 101. G & S: Health spa services for health and wellness of the body and spirit offered at health resorts; health spa services, namely, cosmetic body care services.

Prior Registration(s)

4226104;4226105;4226106

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOTEL & HOMES SOUTH BEACH" APART FROM THE MARK AS SHOWN.

Description of Mark

The mark consists of a numeral "1" located above the text "HOTEL & HOMES" which is located above the text "SOUTH BEACH".

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

2013/09/10

Examining Attorney

FRAZIER, TAMARA

Attorney of Record

Stephen G. Janoski



HOTEL & HOMES
SOUTH BEACH

Print: Dec 11, 2014

78329983

DESIGN MARK

Serial Number

78329983

Status

CANCELLATION PENDING

Word Mark

ONE

Standard Character Mark

Yes

Registration Number

3349279

Date Registered

2007/12/04

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

SH GROUP GLOBAL IP HOLDINGS, L.L.C. LIMITED LIABILITY COMPANY DELAWARE
591 WEST PUTNAM AVENUE GREENWICH CONNECTICUT 06830

Goods/Services

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Hotel services
for preferred customers. First Use: 2007/08/00. First Use In
Commerce: 2007/08/00.

Filing Date

2003/11/19

Examining Attorney

BORSUK, ESTHER A.

Attorney of Record

Stephen G. Janoski

ONE

EXHIBIT E

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD

In the matter of Registration No. 3,505,545
Date of Registration: September 23, 2008
Trademark: MOTEL ONE (and Design)

-----	X	
G6 HOSPITALITY IP LLC,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Cancellation No. 92,057,877
	:	
MOTEL ONE GMBH,	:	
	:	
Registrant.	:	
-----	X	

**MOTEL ONE GMBH’S RESPONSES AND OBJECTIONS TO
G6 HOSPITALITY IP LLC’S FIRST SET OF INTERROGATORIES**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure (“FRCP”) and Rule 405.04 of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), Registrant Motel One GmbH (“Motel One”), by its attorneys, Debevoise & Plimpton LLP, hereby responds and objects to Petitioner G6 Hospitality IP LLC’s (“G6”) Interrogatories, dated October 20, 2014.

Introductory Statement

All of the General Objections set forth herein are incorporated into each of the specific responses and objections to the Interrogatories set forth below and have the same force and effect as if fully set forth therein. Without waiving any of the General

Objections to the extent they apply to each of the interrogatories, Motel One may specifically refer to certain General Objections in responding to particular interrogatories.

These responses and objections are based on information currently available to Motel One and its agents, representatives or attorneys, unless privileged.

Motel One's failure to object to any specific interrogatory on a particular ground or grounds shall not be construed as a waiver of the right to object on any additional ground(s). Motel One reserves the right to object to the competency, relevancy, materiality and/or admissibility of any answers or documents that may be produced in response to the Interrogatories, or the subject matter thereof, and to object on any grounds to the use of any information provided in response to the Interrogatories, or the subject matter thereof, in any subsequent proceedings, including the trial of this or any other matter. Motel One reserves the right to supplement or modify these responses in the event additional or different information becomes available to it, through discovery or otherwise.

General Objections

1. Motel One objects to the Interrogatories to the extent they seek discovery of information relevant to neither the claims nor defenses asserted in this action.
2. Motel One objects to the Interrogatories to the extent they seek discovery of information that is not relevant to the subject matter involved in the action.
3. Motel One objects to the Interrogatories to the extent they seek discovery of information that is neither admissible at trial nor reasonably calculated to lead to the discovery of evidence admissible in this action.

4. Motel One objects to the Interrogatories to the extent they call for disclosure of information or documents protected by the attorney-client privilege, work-product doctrine, or any other applicable privileges (“privileged documents”). Motel One specifically reserves the right, consistent with Fed. R. Civ. P. 26(b)(5)(B), to demand the return of any documents or information that inadvertently may be produced during discovery if Motel One determines that such documents or information contain privileged information. Any inadvertent disclosure of materials protected by the attorney-client privilege, the work product doctrine, or any other applicable privilege or protection from discovery is not intended and should not be construed to constitute a waiver.

5. Motel One objects to the Interrogatories to the extent they are unreasonably cumulative or duplicative.

6. Motel One objects to the Interrogatories to the extent they call for information already in the possession, custody or control of G6, readily available to G6 or obtainable by G6 from public sources.

7. Motel One objects to the Interrogatories to the extent they call for information outside Motel One’s possession, custody, or control.

8. Motel One objects to the Interrogatories to the extent they seek information for time periods not relevant to this action. Unless otherwise specified, Motel One will provide information from January 1, 2007 to the present.

9. Motel One objects to the Interrogatories to the extent they seek information for geographic regions not relevant to this action. Unless otherwise specified, Motel One will provide information limited solely to the United States.

10. Motel One objects to the Interrogatories to the extent they seek information that Motel One, a corporation organized under the laws of Germany, is prohibited from providing by operation of the laws and regulations of Germany and the European Commission. For example, German data protection laws prohibit the disclosure of any personal information (“personal data”) outside of Germany.

11. Motel One objects to the Interrogatories to the extent they ask to be identified “all persons” with knowledge concerning particular documents and subjects as unduly burdensome. Motel One will identify all persons of whom it is aware who possess substantial knowledge or information concerning the documents or subjects. In the event no persons have substantial knowledge or information with regard to a particular interrogatory, Motel One will identify all persons of whom it is aware who have any knowledge or information regarding the identified documents and subjects.

12. Motel One objects to each interrogatory to the extent it is not a single interrogatory, but multiple interrogatories in subparts, and therefore violates the applicable rules, including FRCP 33(a)(1).

13. Motel One’s objections and responses to the Interrogatories do not constitute, and shall not be interpreted as, Motel One’s agreement with, or admission as to the truth or accuracy of, any legal or factual characterizations or allegations stated or implied in any of G6’s specific interrogatories or definitions.

Objection to Definitions and Instructions

1. Motel One objects to G6’s Definition of “Petitioner’s Services” as it incorporates potentially misleading characterizations, assumptions and unsupportable

legal conclusions, including to the extent it suggests that Petitioner engages in hotel services other than motel services.

2. Motel One objects to G6's definition of "Motel One" to the extent it refers to persons or entities other than Motel One on the grounds that such interpretation would render the Interrogatories overbroad and unduly burdensome, would seek information that is irrelevant to the claims and defenses in this action and/or irrelevant to the subject matter of this action, and would render any part of the Interrogatories vague or nonsensical.

3. Motel One objects to G6's definition of "Petitioner" to the extent it refers to persons or entities other than G6 on the grounds that such interpretation would render the Request overbroad and unduly burdensome, would seek information that is irrelevant to the subject matter of this action and not material and necessary to the prosecution or defense of this action, and would render many of the requests vague or nonsensical.

Specific Responses and Objection to Document Interrogatories

Interrogatory No. 1

Identify the persons most knowledgeable about any services marketed, offered, or which Registrant intends to sell, market in the United States.

Response to Interrogatory No. 1

Motel One objects to this request as overly broad and to the extent it seeks information that is irrelevant to this litigation and not reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing general and specific objections, Motel One states that the following persons are the individuals most knowledgeable about the services that Motel One marketed, offered or which it intends to sell or market in the United States under Registrant's Mark:

Dieter Müller	Motel One's Chief Executive Officer.
Philipp Westermann	Former Motel One Co-Chief Executive Officer.
Stefan Lenze	Motel One's General Counsel, Director of Development.
Ursula Schelle-Müller	Motel One's Chief Marketing Officer.

Interrogatory No. 2

Identify the persons most knowledgeable about Registrant's bona fide intent to sell, market, or offer Registrant's Services under Registrant's Mark.

Response to Interrogatory No. 2

Subject to the foregoing general objections, Motel One states that the following persons are the individuals most knowledgeable about Motel One's bona fide intent to sell, market, or offer Registrant's Services under Registrant's Mark in the United States:

Dieter Müller	Motel One's Chief Executive Officer.
Philipp Westermann	Former Motel One Co-Chief Executive Officer.
Stefan Lenze	Motel One's General Counsel, Director of Development.
Ursula Schelle-Müller	Motel One's Chief Marketing Officer.

Interrogatory No. 3

Identify all Persons with knowledge of any likelihood of confusion or actual confusion between Petitioner's Marks and Registrant's Mark.

Response to Interrogatory No. 3

Subject to the foregoing general objections, Motel One states that it is not aware of any Persons with knowledge of any likelihood of confusion or actual confusion between Petitioner's Marks and Registrant's Mark in the United States.

Interrogatory No. 4

Identify all Persons who are or were contractors or employees of Motel One, and who were also formerly employees or contractors of Petitioner, Accor, or any other Person that has owned Petitioner's Marks.

Response to Interrogatory No. 4

Motel One objects to this request as overly broad and unduly burdensome and to the extent it seeks information that is irrelevant to this litigation and not reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing general and specific objections, Motel One states that among its senior management at its headquarters, Dieter Müller, Philippe Weyland and Franz Wiessler were formerly employees of Accor.

Interrogatory No. 5

Identify all Persons known to Motel One who are using as a Mark the word "motel" in conjunction with a numeral or number, in connection with hotel, motel, or temporary- accommodation services, and describe any enforcement efforts Motel One has taken with respect the use of that Mark.

Response to Interrogatory No. 5

Subject to the foregoing general objections, Motel One refers G6 to documents produced by Motel One in response to Petitioner's First Set of Requests for Production of

Documents and Things as well as during earlier settlement discussions—for example, a trademark search report regarding the word “motel” or “hotel” in conjunction with a number or number. Motel One further states that it has not taken any enforcement efforts in the United States with respect to any Marks that use the word “motel” in conjunction with a numeral or number, in connection with hotel, motel, or temporary accommodation services.

Interrogatory No. 6

Identify all Persons known to Motel One who are using as a Mark the word "one" or numeral "1" alone or in conjunction with other words, in connection with hotel, motel, or temporary-accommodation services, and describe any enforcement efforts Motel One has taken with respect the use of that Mark.

Response to Interrogatory No. 6

Subject to the foregoing general objections, Motel One refers G6 to documents produced by Motel One in response to Petitioner’s First Set of Requests for Production of Documents and Things as well as during earlier settlement discussions—for example, a trademark search report regarding the word “motel” or “hotel” in conjunction with a number or number. Motel One further states that it has not taken any enforcement efforts in the United States with respect to any Marks that use the word “one” or numeral “1” alone or in conjunction with other words, in connection with hotel, motel, or temporary accommodation services.

Interrogatory No. 7

Describe how the Registrant's Mark was conceived, including identifying all Persons involved with conceiving the Registrant's Mark.

Response to Interrogatory No. 7

Subject to the foregoing general objections, Motel One states that Dieter Müller conceived of Registrant's Mark. Mr. Müller chose the word "Motel" because it gave the impression of affordability, and he chose the word "One" because it suggested being the top in the category.

Interrogatory No. 8

Describe the circumstances of Registrant first becoming aware of the Petitioner's Marks, including, without limitation, when Registrant became aware of Petitioner's Marks.

Response to Interrogatory No. 8

Subject to the foregoing general objections, Motel One states that, being in the industry, it was aware of many hotel and motel brands at the time it applied to register Registrant's Mark, including Petitioner's Marks (except for those of Petitioner's Marks that had not yet been registered at the time).

Interrogatory No. 9

State the basis on which Registrant had a bona fide intention to use Registrant's Mark, as of July 10, 2007, in connection with the following services that were cancelled from its registration: Providing temporary accommodation; Catering services; and Technical consulting, namely, computer consultation in connection with catering and temporary accommodation enterprises.

Response to Interrogatory No. 9

Subject to the foregoing general objections, Motel One states that, as of July 10, 2007, it had the bona fide intention to expand to the United States, the world's largest

hotel market, in connection with the following services: providing temporary accommodation; catering services; and technical consulting, namely, computer consultation in connection with catering and temporary accommodation enterprises.

Interrogatory No. 10

Identify all Persons from whom Registrant intends to offer fact testimony in connection with these proceedings.

Response to Interrogatory No. 10

Motel One has not yet identified the person(s) from whom it intends to offer fact testimony in connection with these proceedings. Subject to the foregoing general and specific objections, Motel One will identify its trial witnesses in accordance with Fed. R. Civ. P. 26(a)(3).

Interrogatory No. 11

Identify each person whom you expect to call as an expert witness in the trial or hearing of this matter and for each person identified, state the subject matter on which each expert is expected to testify, state the substance of the facts and opinions to which the expert is expected to testify, and provide a summary of the grounds for each opinion.

Response to Interrogatory No. 11

Motel One has not yet identified the person(s) it intends to call as an expert witness at trial. Motel One will identify any such person(s) to G6 in accordance with the requirements of Fed. R. Civ. P. 26(a)(2).

Interrogatory No. 12

Identify all Persons who assisted in the preparation of your responses to Petitioner's discovery requests, including without limitation, those persons who provided information, either directly or indirectly, to the persons preparing the responses.

Response to Interrogatory No. 12

Subject to the foregoing general objections, Motel One states that the following Persons assisted in the preparation of its responses to Petitioner's discovery requests:

Dieter Müller	Motel One's Chief Executive Officer.
Stefan Lenze	Motel One's General Counsel, Director of Development.
Stephanie Biller	Motel One's Counsel.

Interrogatory No. 13

Identify the owner and operator of every business or entity providing temporary accommodations Bearing Registrant's Mark.

Response to Interrogatory No. 13

Subject to the foregoing general objections, Motel One states that, to its knowledge, there are no businesses or entities providing temporary accommodations Bearing Registrant's Mark in the United States at this time, but Motel One intends to do so in the coming years.

Interrogatory No. 14

Identify every business or entity Bearing Registrant's Mark that is not owned or operated by Motel One.

Response to Interrogatory No. 14

Subject to the foregoing general objections, Motel One states that it is not aware of any business or entity Bearing Registrant's Mark in the United States that is not owned or operated by Motel One.

Interrogatory No. 15

Identify the owner of the business or entity Bearing Registrant's Mark that provides services in connection with making reservations of temporary lodging for others.

Response to Interrogatory No. 15

Subject to the foregoing general objections, Motel One states that Registrant owns the website motel-one.com, through which it provides services in connection with making reservations of temporary lodging for others in the United States, and refers G6 to documents produced by Motel One in response to Petitioner's First Set of Requests for Production of Documents and Things—for example, Request No. 17—for information regarding the ownership and corporate structure of Registrant.

Interrogatory No. 16

For each business or entity identified in response to Interrogatory Nos. 13 and 14, state whether the owner or operator is affiliated with Motel One and describe the nature of any such affiliation.

Response to Interrogatory No. 16

Subject to the foregoing general objections, Motel One states: None.

Interrogatory No. 17

Identify all Authorized Users of Registrant's Mark.

Response to Interrogatory No. 17

Subject to the foregoing general objections, Motel One states that it has allowed the following entities to use Registrant's Mark in connection making reservations of temporary lodging for others in the United States:

- Amadeus
- booking.com
- Camao/Motel One
- Clanmo / Motel One
- Expedia
- Expedia.com
- Galileo
- Galileo (Apollo)
- hotel.de
- Motel One (Booker 2.0)
- Motel One (Booker 3.0)
- Orbitz
- Orbitz / ebookers
- Sabre
- TravelNow
- Travelocity.com
- Travelong
- World Choice Travel
- World Ventures Travel
- Worldspan
- www.hotels.com

Interrogatory No. 18

State the basis on which Registrant had a bona fide intention to use the Registrant's Mark, as of July 10, 2007, in connection with making reservations of temporary lodging for others.

Response to Interrogatory No. 18

Subject to the foregoing general objections, Motel One states that as of July 10, 2007, it was already using Registrant's Mark in connection with making reservations of temporary lodgings for others in the United States, and therefore had a bona fide intention to continue to do so.

Interrogatory No. 19

Identify all Persons that have ever owned Registrant's Mark.

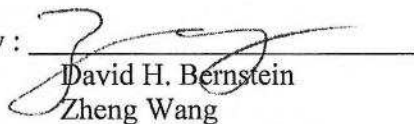
Response to Interrogatory No. 19

Subject to the foregoing general objections, Motel One states that Registrant is the only Person to have ever owned Registrant's Mark and that any changes to the registrant identified in the trademark file of the U.S. Patent and Trademark Office on July 26, 2007 and December 11, 2008 reflect only changes to Registrant's name.

Dated: New York, New York
November 25, 2014

DEBEVOISE & PLIMPTON LLP

By :



David H. Bernstein
Zheng Wang

Debevoise & Plimpton LLP
919 Third Avenue
New York, New York, 10022
Tel: (212) 909-6696

Counsel for Motel One GmbH

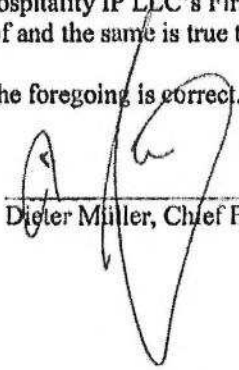
To: Tanya Marie Curcio
Vorys Sater Seymour & Pease LLP
1909 K Street NW, 9th Floor
Washington, DC 20006

VERIFICATION

Motel One GmbH:

I am the Chief Executive Officer of the Registrant Motel One GmbH. I submit this Verification on behalf of Motel One GmbH. I have read the foregoing Motel One GmbH's Responses and Objections to G6 Hospitality IP LLC's First Set of Interrogatories and know the contents thereof and the same is true to my own knowledge.

I swear under penalty of perjury under that the foregoing is correct.



Dieter Müller, Chief Executive Officer

CERTIFICATION OF SERVICE

This is to certify that on November 25, 2014, I caused a copy of the Motel One GmbH's Responses and Objections to G6 Hospitality IP LLC's First Set of Interrogatories to be served by electronic mail upon:

Tanya Marie Curcio
Vorys Sater Seymour & Pease LLP
1909 K Street NW, 9th Floor
Washington, DC 20006
United States
tmcurcio@vorys.com

Executed this 25th day of November, 2014 in New York, New York.

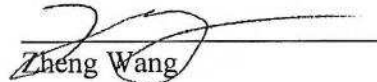

Zheng Wang

EXHIBIT F
INTENTIONALLY OMITTED AS
CONFIDENTIAL

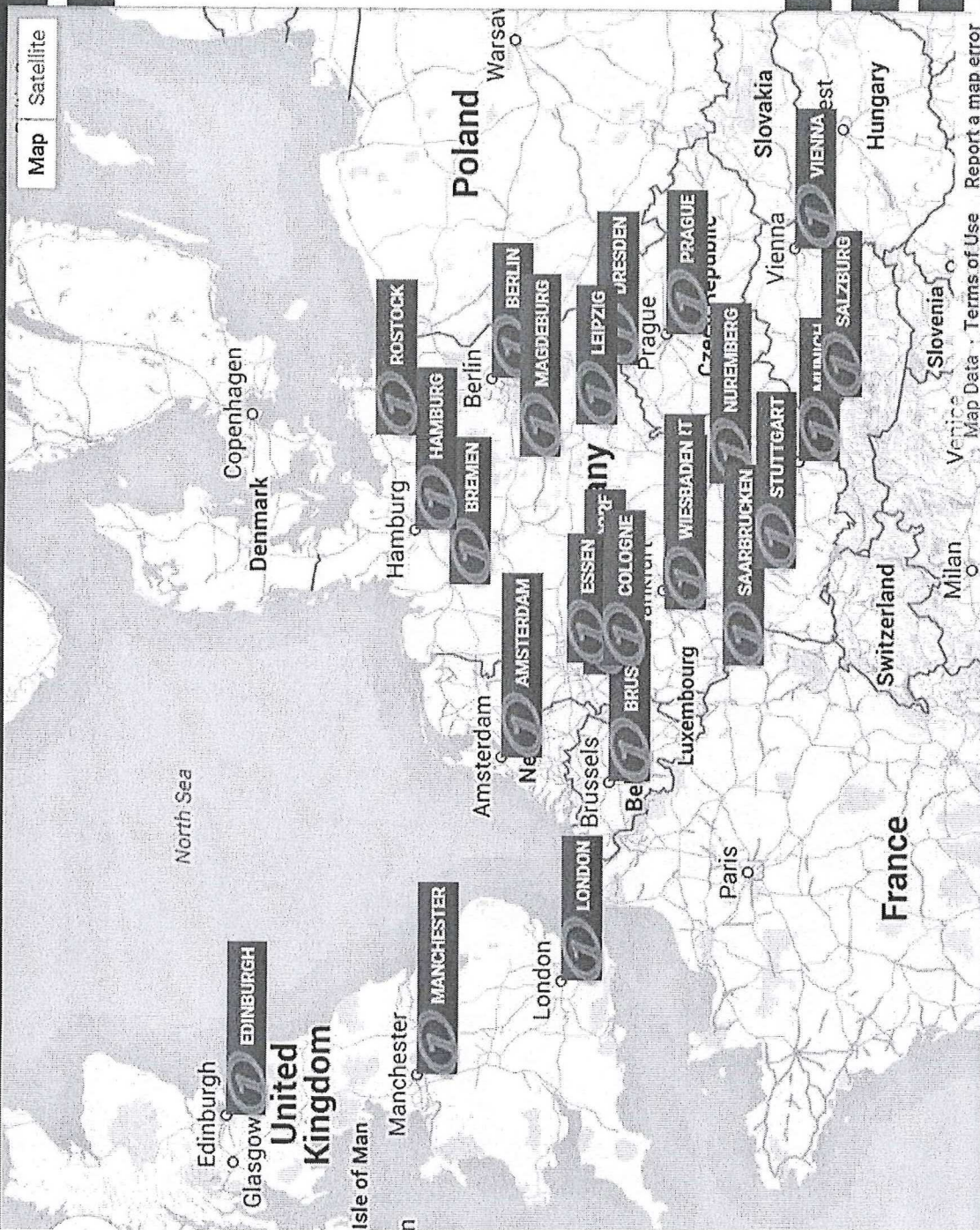
EXHIBIT G

CLOSE MAP



HOTEL ONE

LOGIN



Map Satellite

GERMANY

- BERLIN
- BREMEN
- DRESDEN
- DUSSELDORF
- ESSEN
- FRANKFURT
- HAMBURG
- COLOGNE
- LEIPZIG
- MAGDEBURG
- MUNICH
- NUREMBERG
- ROSTOCK
- SAARBRUCKEN
- STUTTGART
- WIESBADEN

UNITED KINGDOM

NETHERLANDS

CZECH REPUBLIC

EXHIBIT H

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86368963
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION	
MARK	http://tsdr.uspto.gov/img/86368963/large
LITERAL ELEMENT	MOTEL ONE
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi 101147162-20150609124458235421 . Executed Consent Agreement.pdf</u>
CONVERTED PDF FILE(S) (6 pages)	<u>\\TICRS\EXPORT16\IMAGEOUT16\863\689\86368963\xml6\ROA0002.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\863\689\86368963\xml6\ROA0003.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\863\689\86368963\xml6\ROA0004.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\863\689\86368963\xml6\ROA0005.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\863\689\86368963\xml6\ROA0006.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\863\689\86368963\xml6\ROA0007.JPG</u>
DESCRIPTION OF EVIDENCE FILE	a consent agreement between Applicant and the owner of Registration No. 3349279 and Application Nos. 78926922, 78926965, 78927075, 86060308, 86060348 and 86060380 in response to the 2(d) refusal
GOODS AND/OR SERVICES SECTION (class deleted)	

GOODS AND/OR SERVICES SECTION (class added) Original Class (042)

INTERNATIONAL CLASS	043
DESCRIPTION	Providing temporary accommodation; catering services
FILING BASIS	Section 1(b)

ADDITIONAL STATEMENTS SECTION

DISCLAIMER	No claim is made to the exclusive right to use MOTEL apart from the mark as shown.
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SIGNATURE SECTION

RESPONSE SIGNATURE	/Zheng Wang/
SIGNATORY'S NAME	Zheng Wang
SIGNATORY'S POSITION	Attorney for Applicant, NY Bar member
SIGNATORY'S PHONE NUMBER	212-909-6000
DATE SIGNED	06/10/2015
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Wed Jun 10 11:15:16 EDT 2015
TEAS STAMP	USPTO/ROA-10.1.147.162-20 150610111516504060-863689 63-5303a54ab82ea8b9e35104 ffef94fe2b03d7892fb55448a 816878b8a749368d8a-N/A-N/ A-20150609124458235421

**Response to Office Action
To the Commissioner for Trademarks:**

Application serial no. **86368963** MOTEL ONE(Standard Characters, see <http://tsdr.uspto.gov/img/86368963/large>) has been amended as follows:

EVIDENCE

Evidence in the nature of a consent agreement between Applicant and the owner of Registration No. 3349279 and Application Nos. 78926922, 78926965, 78927075, 86060308, 86060348 and 86060380 in response to the 2(d) refusal has been attached.

Original PDF file:

evi 101147162-20150609124458235421 . Executed Consent Agreement.pdf

Converted PDF file(s) (6 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant hereby deletes the following class of goods/services from the application.

Class 042 for Providing temporary accommodation; catering services

Applicant hereby adds the following class of goods/services to the application:

New: Class 043 (Original Class: 042) for Providing temporary accommodation; catering services

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. *For a collective trademark, collective service mark, or collective membership mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. *For a certification mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use MOTEL apart from the mark as shown.

SIGNATURE(S)

Response Signature

Signature: /Zheng Wang/ Date: 06/10/2015

Signatory's Name: Zheng Wang

Signatory's Position: Attorney for Applicant, NY Bar member

Signatory's Phone Number: 212-909-6000

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian

attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 86368963

Internet Transmission Date: Wed Jun 10 11:15:16 EDT 2015

TEAS Stamp: USPTO/ROA-10.1.147.162-20150610111516504

060-86368963-5303a54ab82ea8b9e35104ffef9

4fe2b03d7892fb55448a816878b8a749368d8a-N

/A-N/A-20150609124458235421

CONSENT AGREEMENT

Motel One GmbH ("Motel One") and SH Group Global IP Holdings, L.L.C. ("SH Group") have agreed as of June 8, 2015 (the "Effective Date") that Motel One may register, use and license the mark "MOTEL ONE" in connection with hotel, motel, catering, reservation and related services, and that SH Group may register, use and license the mark "ONE" and marks that include the words "1 HOTEL" and "1 HOTELS" in connection with hotel, motel, catering, reservation and related services.

The following facts form the basis for this agreement:

1. Motel One operates and promotes hotels under the MOTEL ONE mark in numerous countries. On September 23, 2008, it obtained a registration for MOTEL ONE as a design and word mark (U.S. Registration No. 3,505,545) (the "Motel One Registration"). On August 18, 2014, it applied for registration of MOTEL ONE as a standard character mark (Serial No. 86/368,963) (the "Motel One Application").

2. SH Group owns trademark registrations and pending applications for, among others, marks consisting of or incorporating "ONE," "1 HOTEL" and "1 HOTELS" in connection with hotel, motel, catering and/or reservation services. In the United States, SH Group obtained a registration for the mark ONE on December 4, 2007 (U.S. Registration No. 3,349,279) and registrations for marks containing the words "1 HOTEL" on October 16, 2012 (Registration Nos. 4,226,104, 4,226,105 and 4,226,106) (the "SH Group Registrations"). It also has pending applications in the United States for the mark ONE (Serial Nos. 86/975,482 and 86/206,041) and for marks containing the

words “1 HOTELS” and “1 HOTEL” (Serial Nos. 78/927,101, 78/926,922, 78/926,965, 78/927,075, 86/060,308, 86/060,348 and 86/060,380, 86/405,653, 86/405,682, 86/405,697, 86/405,780, 86/405,802, 86/405,821, 86/405,848, 86/405,888, 86/406,035, 86/406,047, 86/406,075, 86/406,093, 86/406,111,) (together, with the pending applications for the ONE mark, the “SH Group Applications”).

For good and valuable consideration, Motel One and SH Group thus agree on the following specific points:

1. The parties hereto in good faith believe, to the best of their knowledge, that there is no likelihood of confusion or conflict between Motel One’s registration or use of “MOTEL ONE” and SH Group’s registration or use of the mark “ONE” or marks containing the words “1 HOTEL” or “1 HOTELS”, and hereby confirm such belief and understanding based upon the following facts:

(a) Motel One’s use of “MOTEL ONE” and SH Group’s use of “ONE” and marks containing the words “1 HOTEL” and “1 HOTELS” are substantially different as to their appearance and commercial impression.

(b) In text, SH Group uses the numeral “1” instead of the word “ONE”, while Motel One uses the word “ONE”; currently, SH Group’s only registration of ONE is in connection with hotel services for preferred customers, and its only applications for ONE are in connection with real

estate services and real estate marketing services in the field of condominiums and apartments.

(c) Motel One uses the word "MOTEL" while SH Group uses the word "HOTEL" or "HOTELS".

(d) Motel One includes the word "ONE" after the word "MOTEL" and, in the case of its logo, with the numeral "1" in close proximity to the words "MOTEL ONE", while, in the case of SH Group's marks, the numeral "1" precedes or is above the word "HOTEL" or "HOTELS".

(e) The parties' logos are completely dissimilar. Motel One's logos include:



SH Group's logos look different, as the examples below illustrate:



2. Subject to the specific terms herein, SH Group consents to the registration, use and licensing by Motel One in the United States of the MOTEL ONE mark in connection with providing temporary accommodation and catering services, and the marketing and promotion thereof.

3. Motel One will not attempt to unlawfully associate itself with SH Group.

4. SH Group will not attempt to unlawfully associate itself with Motel One.

5. The parties agree that nothing herein is intended to in any way restrict competition between the parties with respect to any of the subject goods and/or services referenced herein; rather, the parties recognize that it is in their respective best interests to conduct their practices under their respective designations in such fashion so as to continue to avoid any likelihood of customer confusion, deception, or mistake.

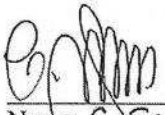
6. This Agreement is binding on Motel One and SH Group, as well as on all

their associated entities and individuals and successors and assigns.

7. This Agreement becomes binding as of the Effective Date once each of parties have signed on the lines below.

SH Group Global IP Holdings, L.L.C.

Motel One GmbH

By: 
Name: C. Scott Rohm
Its: President

By: _____
Name:
Its:

their associated entities and individuals and successors and assigns.

7. This Agreement becomes binding as of the Effective Date once each of parties have signed on the lines below.

SH Group Global IP Holdings, L.L.C.

Motel One GmbH

By: _____
Name:
Its:

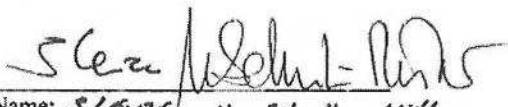
By: 
Name: Stefan U. Schell-Müller
Its: Directors

EXHIBIT I

To: Motel One GmbH (trademarks@debevoise.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86368963 - MOTEL ONE - 24783-1001
Sent: 6/11/2015 3:51:26 PM
Sent As: ECOM115@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86368963

MARK: MOTEL ONE

86368963

CORRESPONDENT ADDRESS:

David H. Bernstein, Esq.
Debevoise & Plimpton LLP
919 Third Avenue
New York NY 10022

GENERAL TRADEMARK INFORMATION
<http://www.uspto.gov/trademarks/index>

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Motel One GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO :
24783-1001

CORRESPONDENT E-MAIL ADDRESS:
trademarks@debevoise.com

SUSPENSION NOTICE: NO RESPONSE NEEDED

ISSUE/MAILING DATE: 6/11/2015

The Office has reassigned this application to the undersigned trademark examining attorney.

This Office Action replies to applicant's response dated June 10, 2015. In its response applicant provided a disclaimer and proper classification for the services which are accepted and made of record. In response to the likelihood of confusion refusal applicant provided a consent agreement between the parties. The consent is unacceptable as specifically addressed below. As such the refusal based on a Likelihood of Confusion is maintained and the trademark examining attorney is suspending action on the application for the reason(s) stated below. *See* 37 C.F.R. §2.67; TMEP §§716 *et seq.*

The effective filing date of the pending applications previously identified precedes the filing date of applicant's application. If the mark in any of the referenced applications registers, applicant's mark may be refused registration under Section 2(d) because of a likelihood of confusion with that registered mark or marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, action on this application is suspended until the earlier-filed referenced applications either register or abandoned. 37

C.F.R. §2.83(c). A copy of information relevant to these referenced applications was sent previously.

Naked Consent

The submitted consent agreement is a “naked consent” and is insufficient to overcome a likelihood of confusion refusal because it does not describe the arrangements undertaken by the parties to avoid confusing the public and/or whether the parties will make efforts to prevent confusion, and cooperate and take steps to avoid any confusion that may arise in the future. *See In re Mastic*, 829 F.2d 1114, 1117-18, 4 USPQ2d 1292, 1295-96 (Fed. Cir. 1987); *In re Permagrain Prods., Inc.*, 223 USPQ 147, 149 (TTAB 1984); TMEP §1207.01(d)(viii) and it is not signed by both parties on the same signature page. Without additional factors to support the conclusion that confusion is unlikely, naked consents are generally accorded little weight in a likelihood of confusion determination. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 568 (C.C.P.A. 1973).

If applicant submits a more “clothed” consent agreement indicating the registrant’s consent to the use and registration of the mark, and addressing one or both of the factors listed above, this refusal will be reconsidered. However, consent agreements are but one factor to be taken into account with all of the other relevant circumstances bearing on a likelihood of confusion determination. *In re N.A.D. Inc.*, 754 F.2d 996, 999, 224 USPQ 969, 971 (Fed. Cir. 1985); *In re E. I. du Pont*, 476 F.2d at 1361, 177 USPQ at 567; TMEP §1207.01(d)(viii).

Factors to be considered in weighing a consent agreement include the following:

- (1) Whether the consent shows an agreement between both parties;
- (2) Whether the agreement includes a clear indication that the goods and/or services travel in separate trade channels;
- (3) Whether the parties agree to restrict their fields of use;
- (4) **Whether the parties will make efforts to prevent confusion, and cooperate and take steps to avoid any confusion that may arise in the future;** and
- (5) Whether the marks have been used for a period of time without evidence of actual confusion.

See In re Four Seasons Hotels Ltd., 987 F.2d 1565, 1569, 26 USPQ2d 1071, 1073 (Fed. Cir. 1993); *In re Mastic*, 829 F.2d at 1117-18, 4 USPQ2d at 1295-96; *cf. Bongrain Int’l (Am.) Corp. v. Delice de Fr., Inc.*, 811 F.2d 1479, 1485, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987).

If the applicant submits a new consent document addressing this issues and properly signed on the same page by both parties then the consent will be clothed and deemed acceptable and the application passed for publication.

Likelihood of Confusion Refusal is Continued and Maintained:

The following refusal is continued and maintained: Likelihood of Confusion Section 2(d).

Suspension:

The USPTO will periodically conduct a status check of the application to determine whether suspension remains appropriate, and the trademark examining attorney will issue as needed an inquiry letter to applicant regarding the status of the matter on which suspension is based. TMEP §§716.04, 716.05. Applicant will be notified when suspension is no longer appropriate. *See* TMEP §716.04.

No response to this notice is necessary; however, if applicant wants to respond, applicant should use the "Response to Suspension Inquiry or Letter of Suspension" form online at <http://teasroa.uspto.gov/rsi/rsi>.

To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and *Document Retrieval (TSDR)* system at <http://tsdr.uspto.gov/>. *Please keep a copy of the TSDR status screen.* If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

To Update Correspondence/e-mail Address:

Use the Trademark Electronic Application System (TEAS) form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

/JSD/

Jeffrey S. DeFord
Examining Attorney
Law Office 115
571 272-9469
jeffrey.deford@uspto.gov

To: Motel One GmbH (trademarks@debevoise.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86368963 - MOTEL ONE - 24783-1001
Sent: 6/11/2015 3:51:27 PM
Sent As: ECOM115@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON 6/11/2015 FOR U.S. APPLICATION SERIAL NO. 86368963

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov/>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see

http://www.uspto.gov/trademarks/solicitation_warnings.jsp.